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No. 89-114

IN THE

Supreme Court of the United States

OCTOBER TERM, 1989

LEONARD M. FREEMAN, M.D.,

Petitioner,

—v.—

HEIDI S. WEISSMANN, M.D.,

Respondent.

BRIEF IN OPPOSITION TO A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

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EDITOR'S NOTE:

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QUESTIONS PRESENTED

Sections 101 (definitions of "created," "derivative work," and "joint work"), 103(b), 201(a) and 107 of the Copyright Act and the case law consistently interpreting them furnish the controlling law on the three key questions: (i) whether a new version of an earlier work contains sufficient newly added "expression" to qualify as a copyrightable derivative work (ii) whether such new material is a "joint work" and (iii) whether an unlicensed use of it meets the criteria for the "fair use" defense.

The Court of Appeals held (i) that P-1, the medical article at issue, contained sufficient new expression to meet the test for copyright protection, (ii) that petitioner was not a "joint author" of the new matter in P-1, because it was conceded that he did not participate in its creation and (iii) that petitioner's verbatim copying of P-1 and misrepresentation of himself as its sole author was not a "fair use".

The questions presented are:

1. Whether petitioner can claim before this Court to have authored the new material in P-1 when he has conceded below that he did not participate in its creation and that his claim of joint authorship of P-1 was only based on having participated in the creation of earlier versions of P-1?

2. Whether by requiring an actual authorship contribution by each would-be joint author, as mandated by the explicit statutory definition of a "joint work" in 17 U.S.C. § 101, the Court of Appeals is encouraging or stifling the creative efforts the Copyright Act is designed to foster?

3. With respect to whether P-1 was a "joint work,"

(a) whether the Court of Appeals properly determined that under Sections 101 and 103(b) of the Copyright Act the copyright ownership of P-1 must be assessed on the basis of the parties' respective contributions to and intentions regarding P-1, as distinguished from their actions regarding earlier versions of P-1, and

(b) whether the Court of Appeals correctly decided that P-1 was not jointly authored: where petitioner conceded that he did not participate in P-1's creation and that his claim of co-ownership was based upon joint authorship of the works from which P-1 was derived; where he failed to offer any evidence of a mutual intent, at the time P-1 was created for its new material to be jointly owned; and where the District Court had made none of the specific findings required by the statute respecting the 1985 creation of P-1, as distinguished from earlier versions of P-1?

4. Whether the Court of Appeals, which made a thorough review of the works themselves, correctly concluded that the new matter in P-1 is copyrightable and that the District Court's contrary conclusion was based upon "clearly erroneous" findings?

5. Whether the Court of Appeals correctly reversed the District Court's holding that verbatim copying of P-1 in its entirety by a professional colleague and competitor, who removed respondent's name and misrepresented his own authorship of it, was a fair use under Section 107 of the Copyright Act?

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JUDGMENT BELOW

The Judgment of the United States District Court for the Southern District of New York (Pollack, D.J.) entered pursuant to the opinion herein of the Court of Appeals for the Second Circuit is reprinted in the Appendix hereto, A-1-2, *infra*.

STATUTES INVOLVED

Section 101 of the Copyright Revision Act of 1976, 17 U.S.C. § 101 (hereinafter the "U.S. Copyright Act"), provides in pertinent part:

> As used in this title, the following terms and their variant forms mean the following:
>
> * * *
>
> A work is "created" when it is fixed in a copy or phonorecord for the first time; where a work is prepared over a period of time, the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work.
>
> A "derivative work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted. A work consisting of editorial revisions, annotations, elaborations, or other modifications, which, as a whole, represent an original work of authorship, is a "derivative work."
>
> * * *
>
> A "joint work" is a work prepared by two or more authors with the intention that their contributions be merged into inseparable or interdependent parts of a unitary whole.

Section 103(b) of the U.S. Copyright Act, 17 U.S.C. § 103(b), provides:

> The copyright in a compilation or derivative work extends only to the material contributed by the author of such work, as distinguished from the preexisting material employed in the work, and does not imply any exclusive right in the preexisting material. The copyright in such works is independent of, and does not affect or enlarge the scope, duration, ownership, or subsistence of, any copyright protection in the preexisting material.

Section 107 of the U.S. Copyright Act, 17 U.S.C. § 107, provides:

> Notwithstanding the provisions of section 106, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include —
>
> (1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;
>
> (2) the nature of the copyrighted work;
>
> (3) the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and
>
> (4) the effect of the use upon the potential market for or value of the copyrighted work.

Section 201(a) of the U.S. Copyright Act, 17 U.S.C. § 201(a), provides:

> Initial Ownership - Copyright in a work protected under this title vests initially in the author or authors of the work. The authors of a joint work are co-owners of copyright in the work.

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Petitioner,

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HEIDI S. WEISSMANN, M.D.,

Respondent.

BRIEF IN OPPOSITION TO A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE SECOND CIRCUIT

Petitioner Leonard M. Freeman, M.D. has requested this Court to issue a writ of certiorari to review the judgment and opinion of the United States Court of Appeals for the Second Circuit entered on February 23, 1989. Because the decision of the Second Circuit is correct and does not raise any questions that are worthy of review by this Court, the Petition should be denied.

STATEMENT OF THE CASE

Introduction

Respondent sued petitioner for copyright infringement. The parties are each leaders in the field of nuclear medicine where publisning and credit for authorship are essential for professional advancement and economic reward.

It was undisputed that without permission, petitioner photocopied respondent's 1985 copyrighted article, P-1, changed its title and substituted his name instead of hers as its sole author. Petitioner's motive was to supply the copy for distribution in a course book for which he was required to furnish his own up-to-date submission. Petitioner conceded he was not a collaborator in preparing the new material in this article, although the parties had been co-authors of certain earlier works on the subject treated in respondent's article. The Court of Appeals concluded that petitioner's copying of the article was a copyright infringement and that the District Court's conclusion to the contrary was based upon a clearly erroneous application of the Copyright Act.

Facts

Respondent is a widely honored researcher and author in the field of nuclear medicine (Pet. App. B-6, 7)[1] and at all relevant times was Associate Professor in the Department of Nuclear Medicine and Radiology, Albert Einstein College of Medicine and Adjunct Attending Physician at Montefiore Medical Center (Pet. App. B-5). In 1985 respondent prepared P-1, an article entitled "Hepatobiliary Imaging" reporting on the state of the art of a diagnostic imaging technique for liver and biliary disorders employing the radioactive analogs of the agent IDA. P-1 was published as a chapter to the Radiological Society of North America's ("RSNA") book entitled "Syllabus: A Categorical Course in Nuclear Medicine". (P-1; E-1).

P-1 was derived from various earlier works, including articles and chapters of medical texts, that the District Court found had been jointly authored from 1979 to 1984. The preparation of P-1 took over a month, including the review of over one-hundred works in the literature and the study of and selection from over

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[1] References to "A- " are to the Joint Appendix in the Second Circuit followed by the page number, to "T- " to the Trial Transcript Volume in the Second Circuit and "E" to the Trial Exhibits Volume in the Second Circuit followed by the page number. References to "P- " and "D- " are to plaintiff-respondent's and defendant-petitioner's trial exhibits, respectively. References to "Pet." are to the Petition for Certiorari and to "Pet. App." are to the Appendix to the Petition for Certiorari.

400 illustrations compiled by respondent (Pet. App. B-15; T-37). The highlighting[2] in plaintiff's Trial Exhibit 13 (Appendix 2 hereto), a copy of P-1, spotlights much of the material in P-1 not present in any of its earlier versions, but does not demonstrate every new copyrightable element such as rearrangement or new combination of earlier material.[3]

Petitioner made no claim to having participated in creating any aspect of P-1 but conceded the contrary throughout the case: at the preliminary injunction hearing petitioner conceded that "the article in question before this court [P-1] was not a jointly authored article" (A-13). At that hearing the District Court "ascertain[ed] that in fact the questioned article [was] authored solely by plaintiff" (A-16). Petitioner's defense was that P-1, while not itself jointly authored, was derived "virtually verbatim" from "prior joint collaborative works" (A-17).

At trial, petitioner's counsel objected to evidence on the "preparation process" for P-1, explaining that "we don't claim, as I told the court in proceedings on August 21st last year, that Dr. Freeman participated in the preparation of the manuscript for this particular piece [P-1], our claim is of joint authorship from the works from which this is derived" (T-56; same T-267). Respondent's following direct testimony was uncontradicted:

Q Did Dr. Freeman have any participation in writing the article?
A Not one word.
Q Did he edit it before it went to the RSNA?
A No, he did not.
Q Did he see a draft before it went to the RSNA?
A No, he did not.

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[2] P-13 as admitted in evidence had this highlighting in red. However, the printer of respondent's Brief could only reproduce the highlighting in yellow in the Appendix hereto. A true copy of P-13 is also being lodged with the Clerk of the Supreme Court.

[3] Other trial exhibits of respondent demonstrated separately the differences between P-1 and each of its predecessors and the new selection and combination in P-1 of pre-existing material by tracing back all of P-1's sections to their different sources. (P-46, P-16 and P-16a).

Q Did he read the gallies?
A No, he did not.[4]

(T-38)

On appeal, petitioner did not question either the fact of these concessions or the accuracy of their content.[5]

Petitioner Freeman is Professor of Nuclear Medicine and Radiology at Einstein and Attending Physician at Montefiore where at relevant times he served over plaintiff as Chief of the Division of Nuclear Medicine. (Pet. App. B-5; D-14 and D-15; T-338). In August 1987, petitioner, without permission (T-102), photocopied P-1, whited out respondent's name and replaced it with his as sole author (T-561-62), added three words to its title and then submitted the article to the Mount Sinai School of Medicine for reproduction and distribution as part of the book for a nuclear medicine conference ("P-2").[6] (Pet. App. B-2; B-15-16).

The District Court Decision

On the facts, the District Court found that Petitioner had copied P-1 as claimed, but made no mention of the key concession that petitioner did not participate at all in the creation of P-1 and gave no separate consideration to the facts relating to P-1's creation. With respect to the earlier works of the parties, the trial court found that "plaintiff [respondent] did almost all

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[4] Petitioner himself also testified that he had nothing to do with the "order in which the sections and information" appeared in P-1 (T-498). When asked whether he claimed to have written "a single word expressly for P-1" apart from "those pieces that you say derive from collaborative work," petitioner also testified that "Aside from what has been demonstrated to be collaborative work, I did not write any additional words for this piece." (T-499).

[5] In answer to respondent's argument that petitioner could not be a joint author where he did not participate in creating the new work, petitioner stated: "It is thus irrelevant that Weissman alone penned the new matter in P-1." (Brief of Def't Appellee, Point I, p. 16).

[6] The trial evidence also included another, retyped copy of P-1's text published under petitioner's name alone in the bound conference book for a symposium held in December 1986 in Taiwan where petitioner guest lectured. (P-34, admitted without objection, T-464). Respondent was not aware of this use at the time, and it was not disclosed in pre-trial discovery (T-456-58).

of the writing", that she routinely submitted "drafts" of these to petitioner "before publication", (Pet. App.B- 10) and that "[s]he [respondent] would always make sure to leave a copy of a manuscript on his desk if he [petitioner] was not in town or busy with other commitments; she did not always get comments back, but she often did." (*Id.*) Although the District Court found that the preexisting works of the parties were created in this manner, no such findings were made with respect to P-1.

On the law, the District Court held that petitioner was a "joint author" and co-owner of P-1 (Pet. App. B-12, B-16 and 17) and then that its "new matter" was too trivial to qualify it for copyright protection as a derivative work because it did not report any "new studies" (Pet. App. B-5). It also explained the latter holding by evaluating the popularity of P-1's subject matter ("by 1985 interest in IDA [P-1's subject matter] had already peaked." Pet. App. B-15). The trial court justified these conclusions by finding that petitioner was an expert "on the appearance or absence of new matter of non-trivial originality" (Pet. App. B-14 - 15), accepting as "credible" his arguments that P-1 reported "nothing new" (Pet. App. B-15) and holding that its copyrightability was "not self proving" by examination of the documents. (*Id.*) The District Court alternatively ruled that petitioner's copying would be "fair use" because it involved a small, $250 honorarium, was done for non-profit, educational purposes and it would help the marketability of P-1 (Pet. App. B-24-25).

The Court of Appeals Opinion

The Court of Appeals reversed the trial court's conclusions on the ownership of P-1, its copyrightability and fair use, holding that (a) the new matter added to P-1 qualified for copyright protection (Pet. App. A-19-20); (b) petitioner was not and could not be a joint owner of the new matter because he had conceded that he had made no contribution and there was no mutual intent in 1985 to collaborate in its authorship (*id.* at 8-15, concurring op. A 31-32)) and (c) the verbatim copying of P-1 by a professional colleague who sought to pass it off as his own was not a fair use when the obvious effect was to deny to the author and rightful owner the only real economic benefit of such an

effort in the academic setting, namely, professional recognition for a scholarly achievement (*id.* at 21-28).

The Court of Appeals specifically identified the District Court's clear errors of law as follows: treating P-1 as part of one "evolutionary" ongoing work in disregard of the Copyright Act's explicit requirements in Sections 101 and 103(b) that the ownership and copyright protection for works prepared in successive versions be determined for each version on a separate basis (Pet. App. A-8-10, 14); failing to consider, as required by the definition of "joint work" in Section 101, petitioner's conceded lack of any role in creating P-1 and the absence at that time of a mutual intent to collaborate by both parties (Pet. App. A-8, 11; 10-14; *see* concurring opinion A-31); failing to properly assess P-1's new matter, including new text, selection and rearrangement,in light of the governing modest legal standard for copyright protection (Pet. App. A-19) and, in its fair use evaluation, disregarding the combined facts of petitioner's wholesale appropriation and attempt to "pass off" the work in question as his own (Pet. App. A-24), while focusing only "upon sales or dollars received, rather than upon the realities of promotion and tenure in an academic setting" in evaluating the real econonic effect and other aspects of the kind of conduct involved. (Pet. App. A-25-28).

The Court of Appeals identified the District Court's clearly erroneous findings of fact as including: that petitioner was a joint author of P-1, even though he conceded that he contributed nothing to its new matter (Pet. App. A-9, 11 and 15); that the parties both intended to collaborate on the creation of P-1, even though there was no evidence to support this (Pet. App. A-13, 14 and 15; *see* A-31 concurring opinion); that respondent's only additions to P-1 consisted of adding "four sources" and repeating verbatim portions of the prior works, with no new selection and rearrangement of material, even though the documents showed this to be untrue (Pet. App. A-19-20) and that the amount and substantiality of material copied by petitioner was "*de minimis*," even though he copied all of P-1's newly-added material. (Pet. App. A-26).

REASONS FOR DENYING THE PETITION

Preliminary Statement

Petitioner, having made no contribution to the medical article at issue, took off respondent's name, substituted his own, and authorized its publication and distribution at a medical conference where he guest lectured. The Second Circuit, following the rules specifically required by the Copyright Act and its long line of precedents, held that respondent, the only author of the material newly added to this version of the work, exclusively owned the new matter and that petitioner had infringed the copyright in this new material. Petitioner could lawfully have used, or "updated" on his own, any of the earlier versions of which he was a joint author by virtue of his contributions to those versions. But having chosen instead simply to copy and publish respondent's new material, when petitioner played no role in its creation, he has infringed respondent's copyright. There is nothing novel or unfair about this result.

The Constitutional purpose of our copyright laws is to encourage authorship by rewarding authors for their creative endeavors.[7] In faithfully applying the Copyright Act, the decision of the Second Circuit demonstrates the wisdom of the Congressional scheme enacted to stimulate the production of works for the public benefit – the rewards of copyright ownership, whether granted to one or more authors, are given in return for actual participation in the creative process. Petitioner is misguided in urging a contrary rule, which would only create a disincentive by rewarding someone for not participating.

Petitioner's case must fail because he made no contribution of any kind to the work at issue. Throughout this case petitioner has repeatedly conceded that he did not participate in the creation of P-1 in any way and also repeatedly represented that his only basis for claiming the right to copy it is the fact that he was a joint author of the earlier versions from which P-1 was derived. Because Sections 103(b), 101 and 201(a) of the Copyright Act, and case law thereunder, unequivocally provide that a

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[7] U.S. Const., Art. I, Sec. 8, Cl. 8.

person cannot be a joint owner solely because he contributes to an earlier version, by his own admission and concessions below, petitioner, who is not an author of any of the new material, cannot meet this standard.

In view of petitioner's numerous and repeated concessions below that he did not participate in the creation of P-1, as noted by the Court of Appeals (Pet. App. A-5,8,11 and 14), the Petition, which contains numerous unsupported, misleading and false statements to the contrary (Pet. 2, 3, 4, 5 and 7), is based upon a supposed factual issue and legal contention not made or raised in the District Court or the Court of Appeals. Such an approach, absent a showing of extraordinary circumstances not present here, is impermissible before this Court.

Finally, Supreme Court Rule 17 requires "special and important reasons" before a writ of certiorari will issue. The Petition offers no reason why this Court should exercise jurisdiction beyond petitioner's disappointment with the result reached below, which was required by the application of well established law to the particular facts of this case. It would thus serve no purpose to re-review the Court of Appeals' appellate review and analysis of the complex trial record, when there is no dispute about the controlling provisions of the Copyright Act and when petitioner does not claim a conflict between Circuits or any unsettled, new or novel question of federal law having general importance and needing to be resolved by the Supreme Court. Nor, as shown below, does petitioner put forth any other basis calling for the Supreme Court's exercise of its discretionary jurisdiction or powers of supervision.

I.

THE FACTUAL AND LEGAL BASIS FOR THE PETITION IS DESTROYED BY PETITIONER'S CONCESSION BELOW THAT HE DID NOT PARTICIPATE IN THE PREPARATION OF THE NEW MATTER IN P-1 AND THAT HIS CLAIM OF JOINT AUTHORSHIP IS INSTEAD ON THE BASIS OF THE WORKS FROM WHICH P-1 WAS DERIVED

This Court's ordinary rule is not to consider issues not raised or litigated in the Court of Appeals. *See Adickes v. S.H. Kress*

& Co., 398 U.S. 144, 147, *n.* 2 (1970). This is especially so where a party is seeking to contest a fact conceded below or to change the legal position it represented to the lower courts. *See, e.g., United States v. Ortiz*, 422 U.S. 891, 898 (1975).

Petitioner has inappropriately maintained before the Supreme Court that his "authorship appears substantially in the work in question" (Pet. 3), that there is newly added material in P-1 "some of which itself was jointly authored" (Pet. 2), "[t]hat with respect to any matters newly added to P-1, petitioner was an active participant in researching and reporting" the same (Pet. 4, citing this as a finding by the District Court), that P-1's "new matter was in substantial part the product of petitioner" (Pet. 5), and that "even the new matter in P-1 had in substantial part originated with petitioner's participation" (Pet. 7, again citing this as a finding by the District Court).

No citations are made to the record beyond the opinions to support these extraordinary statements or any other contention in the Petition. The only mention of petitioner's numerous concessions that he did not participate in P-1 appears at page 14 of the Petition, not in his discussion of the law of joint authorship, but where petitioner boldly and unjustly accuses the Court of Appeals of "concluding out of whole cloth that the District court . . . surprisingly found P-1 to be a joint work 'despite [petitioner's] concession that he had no hand in P-1's preparation.'" (Pet. 14).

In certain instances the Petition mistates outright the authorship of P-1's new material, while in others it attempts to rewrite the record by repeatedly blurring and disregarding the distinction that must be made under Section 103(b) of the Copyright Act between the preexisting and newly added material in a "derivative work," i.e., one based upon a previous version. *See* 17 U.S.C. §101 definitions of "derivative work" and "created."[8]

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[8] Remarkably, the Petition, like the reversed District Court opinion makes *no mention whatsoever* of the above-quoted Section 103(b) and of the Section 101 definitions of "created" and "derivative work" in its entire discussions of the law of joint authorship and the copyrightability of P-1 (Pet., Reasons I and II pp. 1-10). The only mention of the pivotal statutory provision of

(Footnote continued)

By ignoring this key distinction, the Petition over and over again makes misleading statements and contentions, such as those quoted above, never raised in either the District Court or Court of Appeals to the effect that the newly added material "originated" with or was the "product" of petitioner when he did no writing, reviewing, discussing or consulting about any aspect of it. Petitioner never made such claims because from the outset of the litigation, petitioner conceded factually that the contrary was the truth and conceded and clearly represented legally that his claimed right to copy P-1 was based on his participation in the creation of P-1's earlier versions, *not* P-1. Neither the occurrence nor substance of such concessions was challenged in the Court of Appeals.

II.

THE SECOND CIRCUIT'S DECISION CORRECTLY CARRIES OUT THE CONGRESSIONAL SCHEME FOR THE PROMOTION OF WORKS OF AUTHORSHIP: ANY RULING TO THE CONTRARY WOULD NOT ONLY DISREGARD THE STATUTE BUT BE A DISINCENTIVE TO CREATION

Petitioner's argument that the decision below "will have a chilling effect on scientific research" has no merit. The Second Circuit's entirely correct application of the Copyright Act, *see* points III-V *infra*, as envisioned by the Congress, will productively serve to encourage scientific authorship. As explained by the Court of Appeals:

> Encouraging authors to use their talents by holding out a promise of reward for their efforts is the surest way to advance the public welfare. In this case it is necessary to keep in mind the danger that allowing wholesale appropriation of scientific works presents. The personal gain sought by Dr. Weissmann [respondent] may not

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Section 103(b) at all is at page 12 where petitioner aggressively seeks to invoke the statutory distinction between the preexisting material in P-1, which he and respondent were of course both free to use, and the new material, in a disingenuous attempt to minimize the fact that his unlicensed photocopying of P-1, included all of P-1's newly added material, as well.

> be directly related to immediate financial gain, but the copyright protection extended to her work nevertheless provides her with an incentive to continue research -- an endeavor that, if successful, would and has led to professional and monetary benefits.

(Pet. App. A-26) (citations omitted)

Thus, the essence of the Congressional copyright scheme is that the rewards for authorship efforts go to those who actually participate in and contribute to the creation of the copyrightable work.[9] Consistent with this intent, the definition of a "joint work" requires "contributions" by both would-be joint authors. 17 U.S.C. § 101. Petitioner, who seeks a copyright in a work he did not create, is therefore urging upon this Court a policy and rule which flies in the face of the statute literally and which would be a disincentive to the authorship effort that the Constitution authorizes Congress to stimulate in our copyright laws.

The rule petitioner would like, so as to win for himself one case, would completely reverse the statutory scheme, thereby destroying the consistent, historic intent of Congress since 1790 to encourage works of authorship by inducing their creation and then revision through the grant of exclusive rights for limited times. *See* 17 U.S.C. §106. The 1976 Copyright Act has done this by continuing the time-honored rule making joint authors "tenants in common". *See* H.R. Rep. No. 1476, 94th Cong., 2d Sess. ("House Report") at 121. This means that in the absence of an agreement that would "transfer" away all of a joint author's usual rights to license or use the work, which would have to be in writing, *see* Section 204, each joint author by statute has an "independent right to use or license" and exploit the work on a non-exclusive basis.[10] House Report at 121; *see* 1 M. Nimmer & D. Nimmer, *Nimmer on Copyright* (1988), §6.10; *accord*

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[9] This accords with petitioner's professed "philosophy. . . shared by. . . colleagues . . . that no one's name gets put on for being a total non-contributor." (T-440).

[10] The Petition's statement that under the Court of Appeals decision respondent's use of material from the earlier jointly owned works "necessarily infringed" these "along the way to creating P-1" is indicative of the lengths to which it has gone to deceive the Court about the governing law.

District Court, Pet. App. B 19-20. Each author's right includes the right to prepare his own derivative work based upon the work, provided only that he accounts to his joint author for an appropriate share of the profits therefrom. *Id.* The joint ownership rules are specifically reflected in the Judgment now entered in this case by the District Court. (Appendix hereto at A-1 *infra*, ¶ 3)

Petitioner's charge that the Second Circuit's decision would enable one contributing joint author, such as "Mr. Funk", to sue another contributing author, such as "Mr. Wagnall", for publishing their 48th edition because one of them registered the copyright in only one of their names (Pet. 10) totally ignores the facts in this case and has no basis in the law governing the rights of joint authors. Factually, what distinguishes P-1 from petitioner's example of the 48th edition of Funk & Wagnall is that petitioner has *not* participated in creating P-1. Legally, as noted above, in the absence of a collaboration or partnership agreement, where both authors have continued to write together, their work remains a joint one and neither can stop the publication of it by the other or register the copyright solely in his name.

But where, as here, "Mr. Wagnall" has not participated in creating the new dictionary, he is not entitled to publish it without "Mr. Funk's" permission, even though he has the right to create and publish his own 48th edition based upon its predecessors, as petitioner was free to do here. *See Weinstein v. University of Illinois*, 811 F.2d 1091, 1093 (7th Cir. 1987); 1 M. Nimmer, *supra* § 6.06 [B] at 6-15; *accord* District Court Opinion, Pet. App. B and 19-20; and Brief of Def't Appellee [petitioner] in Second Circuit, p. 20. What petitioner was not entitled to do under the statute was to engage in wholesale appropriation of respondent's derivative work, thus necessarily infringing its copyright by copying the protectible new elements added solely by respondent. 1 M. Nimmer, *supra*, § 3.05, at 3-21.

Petitioner's dissatisfaction is therefore not with the meaning of the copyright statute and how it applies but rather with the Copyright Act itself. However, it is obvious that in the absence of an unconstitutional legislative enactment, the Judiciary will not disregard the will of the Congress.

The Congressional scheme, in any event, is not ill-advised or unfair to individuals or would-be collaborators and has not worked an unproductive and equitable result in this case. Each co-owner of a joint work, including petitioner here, is and was encouraged by the statute to bring forward, update and revise scientific works whether or not he has a collaborator.[11] The statute does not discourage continued joint efforts but rather encourages them by the prospects of an efficient sharing of the burdens of preparing a new work so as to do so more easily or quickly than working alone.[12] And where there is not a renewed agreement to work together anymore, the continued revision, development and refinement of the preexisting joint work is still encouraged on an individual basis for the benefit of the public.

In the present case the statute has worked well, as intended: when admittedly petitioner lost interest in what he termed a no longer popular subject (Pet. App. B-15, quoting petitioner, "most investigators . . . moved on to other areas") and did not participate in creating a revision, the respondent was still encouraged to do so on her own. Respondent has thus made available to the public, the most up-to-date, state-of-the-art study on the utility and effectiveness of a technique for diagnosing liver and bile disorders utilizing analogues of the radioactive agent IDA. Without respondent's efforts, there would have been no revision at all.

In sum, even apart from the Petition's disregard of the controlling statutory purpose and rules, *see* III-V, *infra*, petitioner has urged a rule that would be a disincentive by perpetuating a continuing property interest of an inactive ex-co-author

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[11] The District Court's and petitioner's repeated efforts to denigrate P-1 as a mere "update" of "stock" material (Pet. App. B 10 and 15), misses the point that such revision is exactly the kind of authorship effort the copyright laws are designed to stimulate for works of this kind. As conceded by petitioner himself at trial, the value of such works depends upon their containing the most updated material and that was why he chose to copy P-1 when he did (T 489-90).

[12] The one thing that would obviously discourage collaboration would be to have joint authorship result in an inability to be free of its consequences, even after a former collaborator ceases to contribute, thereby undercutting the reward for the one who goes on alone.

without regard to his total lack of participation in creating the kind of work the statute seeks to encourage. To reward one for sitting back and making no contribution would not be in the public interest and would pervert the Constitutional basis for the copyright monopoly.

III.

THE SECOND CIRCUIT CORRECTLY HELD THAT THE NEW MATTER IN P-1, CONCEDEDLY AUTHORED SOLELY BY RESPONDENT, SATISFIED THE MODEST STANDARD OF ORIGINALITY REQUIRED FOR A COPYRIGHTABLE DERIVATIVE WORK

Petitioner does not dispute the legal standard utilized by the Second Circuit on the question of P-1's copyrightability as a derivative work.[13] Rather, Petitioner challenges the application of that standard to the specific facts of this case. As a general rule, lower court decisions turning upon an analysis of the particular facts involved do not merit Supreme Court review. *See United States v. Johnston*, 268 U.S. 220, 227 (1925); *see also Texas v. Mead*, 465 U.S. 1041 (1984).

In any event, the Second Circuit's analysis of the relevant facts here was thorough and accurate. As its opinion notes, the documents show on their face that the District Court erred by ignoring the following new copyrightable elements in P-1:

> (1) a selection and arrangement of photo illustrations and associated captions; (2) references to recent reports in the pertinent literature; (3) selection, condensation, and description of additional source material; (4) several new textual additions; (5) substantial rearrangement of the manner and order of presentation of

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[13] To establish copyright infringement, a plaintiff must prove ownership of a valid copyright and copying by the defendant. 3 M. Nimmer, *supra* §13.01 at 13-3 and 13-4. Since the making of one copy, or authorizing copying, by itself constitutes infringement, *id.* at §8.01[c] at 8-25 & 26 and House Report at 60, and was admitted by petitioner, it was not an issue here.

material contained in the parties' prior joint works; and (6) the addition of a section on "congenital disorders," a revised treatment of "chronic cholecystitis," and the incorporation of Dr. Freeman's "false positive" studies.

(Pet. App. A-19-20). In a work of this kind it is the expression in presenting the material that is protected by copyright. As explained by the Second Circuit in an earlier case,

> [I]n considering the copyright protections due a report of news events or factual developments, it is important to differentiate between the substance of the information contained in the report . . . and "the particular form or collocation of words in which the writer has communicated it." What is protected is the manner of expression, *the author's analysis or interpretation* of events, *the way he structures his material and marshals facts, his choice of words, and the emphasis he gives* to particular developments.

Wainwright Securities Inc. v. Wall Street Transcript Corp., 558 F.2d 91, 95-96 (2nd Cir. 1977), *cert. denied*, 434 U.S. 1014 (1978) (citations omitted) (emphasis added).

The "new textual" material, including illustration captions, constituted approximately 33 percent of the total work. (1168 words out of 3496; *see* P-13, Appendix 2 hereto). To these are added the newly provided elements of selection, rearrangement and emphasis noted above. Petitioner himself admitted that P-1's ordering of text and "particular combination of figures" had not appeared before (TR 496). Plainly, these additions, alone or together, meet the modest requirement for copyright protection accepted universally in all Circuit Courts of the country. *See, e.g., M. Kramer Mfg. Co., Inc. v. Andrews*, 783 F.2d 421, 438 (4th Cir. 1986); *Eden Toys, Inc. v. Florelee Undergarment Co., Inc.*, 697 F.2d 27, 34-35 (2d Cir. 1982); *Original Appalachian Artworks, Inc. v. Toy Loft*, 684 F.2d 821, 824 (11th Cir. 1982); *Kamar International, Inc. v. Russ Berrie and Co.*, 657 F.2d 1059,

1061 (9th Cir. 1981); *Alfred Bell & Co. v. Catalda Fine Arts, Inc.*, 191 F.2d 99, 102-03 (2d Cir. 1951).[14]

Thus, the Court of Appeals correctly reversed the District Court's clear error in denying copyright protection to P-1 on the basis of qualitative judgments as to the novelty or scientific worth of respondent's work (Pet. App. B-14), which this Court has long considered legally inappropriate under the Copyright Act. *See Baker v. Selden*, 101 U.S. 99, 102-03 (1880) ("novelty. . . has nothing to do with . . . copyright") and *Bleistein v. Donaldson Lithographing Co.*, 188 U.S. 239, 252 (1903) (it would be a "dangerous undertaking" for judges to decide on the "worth" of works in determining the scope of copyright protection); *see also* 1 M. Nimmer, *supra* § 3.03, at 3-10.[15]

The Court of Appeals was also clearly correct in relying on its own assessment of the new matter in P-1 from the documents themselves in finding copyrightable subject matter. Since the District Court had used the wrong legal standard on

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[14] Petitioner's claim that "all illustrations" in P-1 "were of petitioner's authorship" (Pet. 9) in order to suggest that he played any role in the new selection and arrangment of P-1's figures is still another demonstrably false and misleading statement. The District Court's assertion that two of P-1's new references were to figures "both of which were originally prepared by Freeman" (Pet. App. B-15) is similarly inaccurate and irrelevant. P-13's highlighting of P-1's new matter does not include the photo-illustrations themselves, as distinguished from their selection and combination. P-1 itself also shows that the source for each and every "Figure" is a work authored or co-authored by respondent Weissmann, including references 32 and 33 apparently referred to by the District Court. *See* A-12-13 *infra*. That petitoner may also have been one of the co-authors of an earlier illustration source has nothing to do with the newness of P-1's added selection and rearrangement of the illustrations and of related explanatory text and has nothing to do with petitioner's lack of participation in creating this new expression.

[15] The District Court held that P-1 was not copyrightable because it "did not report anything of substance that was new in the field" (Pet. App. B-10) and only included material that "updated" an "old stock piece" (Pet. App. B-15) and because by 1985 "interest in IDA [the medical subject] had already peaked" (Pet. App. B-15). Thus, the District Court's own reasoning shows that it was erroneously guided by an improper search for "novelty" or a "new discovery" that runs counter to the most basic tenets of copyright law.

copyrightability, its credibility assessments on the presence of such copyrightable subject matter were clearly irrelevant, as the Second Circuit properly perceived:

> Credibility . . . is scarcely pertinent to determining whether . . . the newly-added matter satisfies the statutory requirements for protectability. Research has not revealed a single case in which credibility has been deemed significant — let alone dispositive — on the question of whether there is a sufficient level of originality in a given work to render it copyrightable.

(Pet. App. A-19). *Accord*, 1 M. Nimmer, *supra*, §2.01 at 2-11 (quantum of originality presents "legal question" requiring "judicial line drawing"). The trial judge cannot insulate such erroneous legal conclusions from appellate review simply by labeling them as credibility determinations. *See Anderson v. City of Bessemer*, 470 U.S. 564, 575 (1985).[16]

Further, appellate courts often overturn trial court findings of fact without a violation of the principles of Rule 52(a) or Supreme Court precedents requiring adherence to that rule. As these precedents make clear, the Supreme Court's admonition that the "clearly erroneous" rule of Rule 52(a) be applied to all findings of fact is not meant to imply criticism of appellate courts

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[16] Findings employing code-words and labels, for example, that petitioner was "chief", "mentor" and "principal investigator" for a drug company and contentions that respondent was "junior" (Pet. App., Questions Presented, No. 1) are therefore totally irrelevant. In addition, although not the basis for respondent's appeal, the District Court decision is replete with innumerable, clear factual mistakes and distorted findings showing not only an erroneous portrayal of the issues as ones of credibility but a lack of care which pervades its opinion. These include portraying plaintiff as a neophyte instead of an Associate Professor and award winning author who graduated from medical school 15 years ago; stating that plaintiff sued even though defendant had already agreed to withdraw the infringement (Pet. App. B-2; *compare* with temporary restraining order hearing transcript A-16, 17); stating with respect to the prior versions of plaintiff's article that the Einstein 1980 (D-5) and Harvard 1980 papers (D-1) are "virtually identical" with only "two or three additional sentences" in D-5 and that D-1 preceded D-5 (Pet. App. B-11), which is disproved by the documents themselves (E-357 and E-435), and that the Harvard 1982 article uses figures (Pet. App. B-11), again, disproved by looking at D-45 (E-488).

for rejecting findings of fact which leave them "with a definite and firm conviction that a mistake has been committed," as was done here. (Pet. App. A-21). *See, e.g., Bose Corp. v. Consumers Union of United States, Inc.*, 466 U.S. 485, 499 (1984); *McAllister v. United States*, 348 U.S. 19, 20 (1954); *United States v. United States Gypsum Co.*, 333 U.S. 364, 395 (1948).

Finally, petitioner's claims that P-1's new matter, included his solely authored discussion of "false positives" (Pet., *e.g.*, 4 & 9) are belied by the record as well as irrelevant. The documents establish that P-1's "false positives" section was not newly added to P-1 but appeared earlier in the jointly owned Harvard 1984 and in the Mount Sinai 1984 papers[17] (*compare* P-1, E 12-14, also in the Appendix hereto at A-7-9, *infra.*, with D-34 at E 484-486 and with D-4 at E 427-29). It is consequently not highlighted in P-13 (Appendix A-7-9, *infra.*). The District Court itself therefore found such material to be part of P-1's jointly owned "standard" predecessors (Pet. App. B-11) and subject to "mutual use" as one of P-1's prior "collaborative efforts" (Pet. App. B-14), to which use petitioner stated he had "no objection" (petitioner at T-491 and 92).[18] Thus, the false positive section was preexisting material and has no relevance to whether P-1's new matter is copyrightable or jointly authored.

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[17] Petitioner has consistently claimed that P-1 was part of one jointly owned "evolutionary" work which included all of P-1's predecessors, including the Harvard 1984 paper and P-1's most immediate predecessor, the Mount Sinai 1984 paper. Petitioner's main Brief in the Court of Appeals also stated with respect to the Mount Sinai 1984 paper: "It incorporated all sections previously used, including Freeman's 'false positive' section [A-200]" citing the District Court at Pet. App. B-11). Brief of Def't Appellee p. 12

[18] Also, contrary to the petition's suggestions that P-1's illustrations consisted of the certain "accompanying false positive slides", (*e.g.*, Pet. 4), P-1's false positive discussion, *see* Appendix hereto, at A-7-9, *infra*, does not even include reference to illustrations and these slides were not utilized for P-1. The District Court did not find any use of false positive slides in P-1, either; it only found that petitioner had earlier in 1983 used such slides in his lecturing (Pet. App. B 13-14). All of the illustrations ("Figures") appearing in P-1 are, in any event, identified as originating in earlier works co-authored by respondent Weissmann and apart from their selection and rearrangement in P-1, do not form part of P-1's new matter. *See* note 14 *supra*.

IV.

THE SECOND CIRCUIT CORRECTLY HELD THAT PETITIONER'S "JOINT WORK" DEFENSE FAILED, WHERE HE CONCEDEDLY DID NOT PARTICIPATE IN THE CREATION OF ANY OF THE NEW COPYRIGHTABLE MATTER IN P-1 AND WHERE HE CLAIMED JOINT OWNERSHIP ONLY ON THE BASIS OF EVIDENCE RELATING TO THE PARTIES' CO-OWNERSHIP AND INTENTIONS WITH RESPECT TO PRIOR WORKS

Petitioner had to meet each of the following statutory criteria for P-1 to be a "joint work" (i) under Section 101, each would-be joint author must be a contributing party; (ii) under Section 101, the intention to contribute to a joint work must be found at the time one's contribution is made; and (iii) by reason of Section 103(b), one's intention (or even agreements) with respect to other earlier works (including ones from which new works are derived) cannot be the basis for an ownership determination of a derivative work.

Petitioner's attempt to transform the routine application of these rules into an issue qualifying for Supreme Court consideration by inaccurately portraying the basis for the Second Circuit decision as disagreement with the trial court's findings of fact (Pet. 7) will not stand up. The Second Circuit was not bound by, and was proper in rejecting, those District Court findings which were predicated on an erroneous legal standard. (A-8, citing *United States v. Parke, Davis & Co.*, 362 U.S. 29, 44 (1960)).

The Court of Appeals specifically identified a comprehensive series of errors of law that infected the District Court's entire opinion on joint ownership. First, under the Copyright Act, protection is afforded to each work at the moment of its creation. In the case of works prepared in different versions, "the portion of it that has been fixed at any particular time constitutes the work as of that time, and where the work has been prepared in different versions, each version constitutes a separate work."

17 U.S.C. §101 (definition of "created"). Accordingly, the Petition's attack on the Court of Appeals for rejecting the District Court's attempt to lump P-1 and the prior collaborative works of the parties together as a single "evolutionary" work disregards the plain language of the Copyright Act which prohibits such treatment.[19]

This error of law led to a further error in failing to consider the effect of Petitioner's concessions concerning his lack of participation in creating P-1, plainly vitiating the District Court's purported findings of fact and legal conclusions with respect to copyright ownership. Under such circumstances, the Second Circuit quite properly held that the District Court's findings of fact were not binding on it. See 5A J. Moore, *Moore's Federal Practice* (2d ed. 1988) ¶52.03[2], at 52-79; C. Wright & A. Miller, *Federal Practice and Procedure* (1971) ¶2585, at 734. *See also United States v. Parke, Davis & Co.*, 362 U.S. 29 (1960).

Finally, the Second Circuit held that the District Court had totally failed to grasp the combined effect on P-1's ownership of the statutory rules applicable to a "joint work" under Section 101 and to a "derivative work" under Section 103(b).[20] Under Section 101, each purported joint author must actually "contribute" to what is "prepared" to comprise the work in question, *and* must intend to make a contribution to a joint work at the time the contribution is made. *See* House Report at 120; 1 M. Nimmer, *supra*, § 6.05 at 6-12. Section 103(b) provides that

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[19] The Petition's effort to avoid the statute has gone so far as to decline even to set forth the text of these provisions in a "Statutes Involved" section or Appendix.

[20] Petitioner's argument is erroneous in maintaining that such a work must be *either* joint *or* derivative. (Pet. 9; Questions Presented No. 2(b)) The issue of "ownership," dealt with in Chapter Two of the Copyright Act ("Copyright Ownership and Transfer") has nothing to do with the issue of copyrightability of a work, whether or not a derivative work, governed by Chapter One ("Subject Matter and Scope of Copyright"). Thus, a work based upon any prior work may be a copyrightable derivative work if it meets the standard of embodying more than trivial originality. *See* III *supra*. If it meets this standard, then the ownership of the new work and whether it is singly or jointly owned, is a separate question.

the copyright protection and ownership for derivative works "is independent of" ownership of "any copyright protection in the preexisting material." Accordingly, the Second Circuit properly ruled that "an intent to contribute or an actual contribution to previous works does not serve as proof of ownership in the derivative work."[21] (Pet. App. A-9, citing House Rep. at 103, 120). Thus, all of the District Court's discussion of the parties' intentions to collaborate and merge their efforts, including the passages cited by petitioner, relate only to the predecessors of P-1 (before 1985) when the parties were found to have been "unquestionably collaborators" (Pet. App. B-12), *not* P-1.[22]

Petitioner's attempt to reargue the joint ownership point simply disregards entirely the contribution requirement. Petitioner reads out of Section 101 the words "contributions" and "prepared," reads out of its own quotation from the *Marks* case (Pet. 7) the words "their contributions" and similarly reads out of every other authority on joint authorship the requirement of that each would-be joint author make a contribution by actually engaging in the "joint laboring" identified by the District

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[21] This is specifically explained in the House Report at 120 and considered basic copyright doctrine. *See* 1 M. Nimmer, *supra*, §6.05 at 6-12; (Pet. App. A-10 and authorities there cited).

[22] For example, the reference to a "common design" (Pet. App. B-9) was to years ago when plaintiff was "a fourth year resident" (*id.*), *i.e.*, in 1977 (*see* Pet App. B-6). This also identifies no authorship of any particular work at any specific date. The statement that the parties impliedly "had agreed" that either could use "the stock piece" (Pet. App. B-12) was, similarly, made with reference to the period before petitioner conceded he played no role, not to 1985 when P-1 was created. Moreover, the parties Joint Pretrial Order stipulates that petitioner "did not request nor receive permission" from respondent to use P-1. (A-62). The District Court's statement that P-1 "originated as the result of this collaboration" and that "[b]eginning in about April 1980" the parties prepared a syllabus to use for various courses (Pet. App. B-9 and 10), again, does not relate to P-1 in 1985 - *all* derivative works "originate" as the result of their predecessors, but this did not alter their status as separate works. *See* 17 U.S.C. §§101 (def. of "created") and 103(b). In the same category is the District Court's reference to P-1's use of the term "we" which comes from P-1's predecessors, not its new material. *See infra*, p. 24.

Court itself as "the essence of a joint work." (Pet. App. B-19 and 20).[23]

It is basic that petitioner's co-ownership rights in the prior joint works provide him with no property rights in the new derivative work, P-1. *See, e.g., Weinstein v. University of Illinois*, 811 F.2d 1091, 1093 (7th Cir. 1987); *Dynamic Solutions, Inc. v. Planning and Controls, Inc.*, 646 F. Supp. 1329, 1338-39 (S.D.N.Y. 1986); *MCA, Inc. v. Wilson*, 425 F.Supp. 443, 455 (S.D.N.Y. 1976), *aff'd*, 677 F.2d 180 (2d Cir. 1981). Any contrary rule would, as the Second Circuit indicated, "convert all derivative works based upon jointly authored works into joint works, regardless of whether there had been any joint labor on the subsequent version." (Pet. App. A-8).

The Petition's distorted focus on petitioner's intent similarly misses the point that "it takes two to tango", i.e., that the requisite intent must be joint, not unilateral, and that the mutual intent must be to merge joint "contributions."[24] Instead of addressing the need for mutuality, petitioner contends that P-1 should be a joint work because respondent, allegedly, failed to communicate to petitioner that he was no longer collaborating with her. (Pet. 6, 8). However, as noted by the concurring opinion, it was petitioner's burden, not respondent's, to demonstrate that respondent intended P-1 to be a joint work, and the District Court committed a clear error by reversing that burden.[25] (Pet. App. A 31-32).

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[23] As explained by the Court of Appeals in discussing the *Marks* decision, *Edward B. Marks Music Corp. v. Jerry Vogel Music Co.*, 140 F.2d 266 (2nd Cir. 1944) (L. Hand, J.), the fact that a songwriter and lyricist do not know each other does not eliminate the requirement for a "joint work" that (a) both contribute to the song and (b) both have an understanding and intent to have their contributions merged. (Pet. A-12)

[24] There is no disagreement in the Second Circuit majority on this point (Pet. App. A-9; concurring op. Pet. App. A-31).

[25] Petitioner's contention would, in effect improperly place on each joint author, who by statute has the right to prepare alone a derivative work, the burden of having to make an arrangement for non-collaboration, failing which the non-participating party would continue to be rewarded irrespective of his failure to participate in the work. Such a result would nullify the Congressional scheme.

Every piece of hard evidence refutes petitioner's attempt to challenge respondent's intent to reserve her authorship rights to herself. First, as petitioner concedes, respondent did not seek petitioner's assistance in doing any of the work. Second, respondent's curriculum vitae excluded P-1 from those specifically identified works which the parties had co-authored. (Pet. App. A 13-14). *Inclusio unius est exclusio alterius*. Petitioner's argument that this evidences co-authorship of P-1 (Pet. 5) is completely illogical,[26] only underscoring the absence of any proof that respondent intended P-1 to be a joint work. (Pet. App., concurring op., A 31-32). Third, respondent used only her own name as author. When she publicly presented and distributed P-1 at the same 1985 RSNA meeting where both appeared and submitted chapters on different subjects, petitioner made no objections. (E-6; Pet App. A 13-14).[27]

In the face of such material and uncontroverted facts, the absence of any trial testimony or other evidence to carry petitioner's burden of overcoming his own concessions and the above-noted evidence is fatal to establishing a joint work defense. (*Id.* at A-13-14). There is also no finding in the District Court opinion that petitioner did not know that respondent was preparing P-1 without him or that this was not communicated to him. The Court of Appeals, including the opinions of both Judges Cardemone and Pierce, therefore correctly

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[26] The significance of this exclusion was further confirmed by petitioner's testimony that he "never" asked that his name be utilized when he did not "contribute as an author," that he declined to have his name included when, "for whatever the reason . . . I did not feel I had the time to allot to her and to allot to that particular project." (T-360 and 61).

[27] Petitioner's charge that "under the majority's convolution . . . either contributor" to a joint work could years later "surreptitiously" register alone and sue the other (Pet. 5) is ridiculous and has no relation to this case. Petitioner here conceded he was not a contributor. If he had been, of course, he could not be sued for using a joint work. *See* pp. 11-12, *supra*. Nor was respondent's creation and publication of P-1 at the 1985 RSNA conference attended by petitioner "surreptitious." It was only after *his* surreptitious infringement that the work was registered so that respondent could sue. (Pet. App. A-6).

agreed that petitioner had "failed to produce any evidence to rebut" the above showings. (Pet. App. A-14; *see* Pet. App. A-31 concurring op.).[28]

In still another inaccurate statement, petitioner desperately attempts to conjure up evidence of mutual intent for P-1 to be a joint work in the article's use of the institutional "we" in recommending a technique. But "we" appears not in P-1's new matter highlighted in P-13, but in its preexisting jointly authored material. (P-13, Appendix hereto at A-4, *infra*.). The record confirms the accuracy of P-13's highlighting by showing the prior use of such language in the 1984 Mount Sinai paper (D-4; *see* "Technique" at E-425).

Finally, the Court of Appeals has already evaluated, and then rejected, petitioner's contention that the record shows the existence of a practice evidencing respondent's intent for P-1 to be a joint work. The Court of Appeals was clearly correct in concluding from the fact that P-1 "was the only work with respect to which it was repeatedly conceded he [petitioner] has played no role," (Pet. App. A-14), that any prior "practice" respecting earlier jointly authored works, even if it existed, would have been inapplicable to P-1.[29] Petitioner's effort to reargue the practice point totally disregards the key differences between the creation

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[28] Furthermore, at the time P-1's predecessors were prepared, petitioner's intent was arguably to be an author of a particular article for particular publications. P-1 and other future versions did not exist and were at most possible expectations. Accordingly, he could have had no specific intention at that point to merge his prior efforts into unspecified future works in which he had no role.

[29] The Petition also flatly misstates the District Court's text as a finding of a "long standing practice" (Pet. 8). The trial court only stated there was "some indication of a practice" of using individual by-lines with respect to P-1's predecessors in instances where only one of the parties "was to appear before the audience" (Pet. App. B-11) The manner in which P-1 was presented and published would not fit into any supposed practice of this kind, in any event, because *both* of the parties appeared "before the audience" at the 1985 RSNA conference where P-1 was distributed under respondent's name.

of P-1 and its predecessors, treating them all as one "evolutionary" work. This is not only inconsistent with the facts differentiating P-1's creation and ownership from its predecessors' but also ignores the requirements of Sections 101 (definition of "created") and 103(b) that determinations of ownership be made on a separate basis for each work. Petitioner did not establish the existence of such a practice in any case.[30]

V.

THE SECOND CIRCUIT CORRECTLY HELD THAT PETITIONER'S UNAUTHORIZED REPRODUCTION OF RESPONDENT'S WORK IN ITS ENTIRETY WAS NOT A "FAIR USE"

Petitioner next seeks to invoke this Court's jurisdiction by arguing that the Second Circuit misapplied the fair use doctrine. Evaluation of the fair use defense requires that the particular facts of each case be individually examined. *See Harper & Row Publishers v. Nation Enterprises*, 471 U.S. 539, 549 (1985). In attempting to engage this Court in an additional review of the particular facts on which the fair use issue was decided by the Second Circuit, petitioner once again misperceives the nature of the Supreme Court's supervisory role in our judicial system. *See* p. 14 *supra*.

As the Second Circuit recognized here, the fair use doctrine turns not upon application of inflexible rules, but rather upon

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[30] The record concerning the petitioner's omission of respondent's name from the parties' joint Harvard 1984 paper actually contradicts the existence of the claimed practice because respondent had no knowledge of petitioner's actions. Apart from the undisputed fact that, unlike P-1, this was one of the parties' jointly authored works, *see* Reason III, *supra*; Pet. App. B-14; T 491-92 and D-4, plaintiff's testimony on direct and cross was that when she complained to defendant in 1984 about his intended omission of her name, he told her it was an oversight that he would rectify (T-102-04; 180, 225). Plaintiff did not learn until 1987 after bringing this action that defendant had failed to take the promised corrective action (T-102). Defendant did not deny this and the District Court decision contains no finding rejecting this uncontradicted testimony.

a fact specific "equitable rule of reason" analysis. (Pet. App. A-22, citing *Sony Corp. of America v. Universal City Studios*, 464 U.S. 417, 448 (1984); House Report at 65). Where, as here, the trial decision on fair use was based on erroneous legal standards or erroneous findings of fact, the Court of Appeals was properly free to overrule the lower court. *See, e.g., Financial Information, Inc. v. Moody's Investors Service, Inc.*, 751 F.2d 501, 508 (2nd Cir. 1984).

There is in any event no basis for finding any error on the part of the Second Circuit holding that petitioner's obliteration of respondent's name from P-1 and distribution of verbatim copies under his own name could not be embraced within the equitable doctrine of fair use, which above all else "presupposes 'good faith and fair dealing.' " *See Time, Inc. v. Bernard Geis Associates*, 293 F. Supp. 130, 146 (S.D.N.Y. 1968). The Second Circuit could not find a single case sustaining a fair use defense where the copying was wholesale and involved a denial and substitution of authorship credit (Pet. App. A-23).

Petitioner's attempt to justify the District Court's complete disregard of petitioner's attempt to pass off P-1 as his own work is not overcome by his contention that there was "an uncontravened finding that the parties routinely attached one of the others' by line to syllabi containing the work of both of them." (Pet. 10). As noted above, the new matter in P-1 did not contain "the work of both of them". On the contrary, P-1 was the only instance in which it was agreed that petitioner made no contribution so that there is no precedent that can be drawn from P-1's predecessors which were jointly authored works. *See* pp. 24-25 *supra*.

Petitioner's arguments with respect to the specifically enumerated statutory factors under section 107 of the Copyright Act fare no better. As Judge Cardamone explained, both petitioner and the district court improperly limited their field of vision to the immediate dollars received from petitioner's copying (a $250 honorarium for a lecture) in assessing the first statutory factor, the purpose and character of the defendant's use (Pet. App. A-24). For authors of scientific studies like P-1,

a fact specific "equitable rule of reason" analysis. (Pet. App. A-22, citing *Sony Corp. of America v. Universal City Studios*, 464 U.S. 417, 448 (1984); House Report at 65). Where, as here, the trial 57 U.S.L.W. 3812 (1989). Petitioner "stood to gain recognition among his peers in the profession and authorship credit with his attempted use of [respondent's] article" without "paying the usual price" of authorship effort. (Pet. App. A-24). The small size or even absence of an honorarium is beside the point.

With regard to the second factor, the nature of the copyrighted work, the District Court blindly concluded that scientific fact-based works should be accorded a limited scope of protection without ever addressing the real economic incentive copyright protection provides to the creation of such works. *See, e.g., Mazer v. Stein*, 347 U.S. 201, 219 (1954). In so doing, it committed an another error of law that rendered its factual conclusion clearly erroneous (Pet. App. A-25-266).

In evaluating the third factor, the amount and substantiality of the use, the District Court simply disregarded the fact that petitioner appropriated P-1 in its entirety (Pet. App. A-26-27). Petitioner's emphasis that P-1 embodied some material from prior works of which he was a joint author (Pet. 12) is wholly beside the point. By engaging in wholesale appropriation of a derivative work, petitioner has copied not simply underlying material of which he is entitled to make use, but *all* of the protectible new elements as well. 1 M. Nimmer, *supra*, § 3.05, at 3-21. *See* Point III *supra*. In fair use determinations, the copying of entire works is considered a significant negative factor. *See, e.g., Rosemont Enterprises, Inc. v. Random House*, 366 F.2d 303, 306 (2nd Cir. 1966) cert. denied 385 U.S. 1009 (1967); *Withol v. Crow*, 309 F.2d 777, 780 (8th Cir. 1962); *Walt Disney Productions v. Mature Pictures Corp.*, 389 F.Supp. 1397, 1398-99 (S.D.N.Y. 1975). *See also* 3 M. Nimmer, *supra*, § 13.05[A] at 13-79; § 13.05[D], at 13-90.10 to 13-90.11.

Finally, on the fourth factor, the effect on the market for or value of the work, the Second Circuit properly corrected the clear error of the District Court in ignoring the economic realities for authors in the academic world. In any realistic sense these

include promotion and advancement based on one's publications and scientific achievements (A-27-28). It would severely disrupt the market for works of scientific research and serve as a disincentive for the creation of these works were the fair use doctrine applied in such a way as to focus only on minimal lecture honorariums and sales figures without regard to more important economic considerations of "promotion and tenure" (*Id.*).

In sum, the Second Circuit properly corrected the clear errors of law made in the district court and applied the fair use doctrine to the particular factual circumstances of this case, taking into account the specific context of scholarly scientific research.

CONCLUSION

For the foregoing reasons, the Petition for Certiorari should be denied.

August 11, 1989

Respectfully submitted,

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Of Counsel

APPENDIX

UNITED STATES DISTRICT COURT
SOUTHERN DISTRICT OF NEW YORK

HEIDI S. WEISSMAN, M.D.,

Plaintiff,

— against —

87 Civ. 6069 (MP)

LEONARD M. FREEMAN, M.D.,

Defendant.

JUDGMENT

In accordance with the Order of the Court of Appeals filed February 23, 1989 and issued as a mandate April 24, 1989 ordering, adjudging and decreeing that the Judgment previously entered herein May 11, 1988 be affirmed in part, reversed in part and remanded for further proceedings in accordance with the Opinion of the Court of Appeals dated February 23, 1989, it is

ORDERED, ADJUDGED and DECREED:

1. That the article entitled "Hepatobiliary Imaging," (plaintiff's Exhibit 1 or P-1) is a copyrightable derivative work owned by the plaintiff, Heidi S. Weissman, M.D., as registered on November 9, 1987, in the Office of the Register of Copyrights under Entry No. TX:2-172-705;

2. That defendant Freeman's use of plaintiff's aforesaid article (P-1), complained of by plaintiff, was not a fair use of it and therefore constituted copyright infringement;

3. That defendant be and hereby is permanently enjoined from reproducing copies of, or otherwise using in violation of plaintiff's exclusive rights therein under the Copyright Act, copyrighted material contributed by the plaintiff to the aforesaid article (P-1), excluding material previously incorporated in the parties' joint-work syllabi, material authored or created in whole or in part by the defendant and material not authored or created in whole or in part by plaintiff.

4. That the defendant's application for an award of attorneys' fees pursuant to 17 U.S.C. § 505 and Rule 11, Fed.R. Civ.P., is denied; and

5. That the plaintiff, Heidi S. Weissman, M.D., residing at 29 West Church Road, Saddle River, New Jersey 07458 recover of the defendant Leonard M. Freeman, M.D., residing at 11 Verity Lane, Roslyn, New York 11576 the costs and disbursements of this action incurred in this Court, to be taxed and entered herein by the Clerk and have execution therefor.

Dated: New York, New York
July 11, 1989

/s/ Milton Pollack
Milton Pollack
Senior United States District Judge

JUDGMENT ENTERED:

/s/ Raymond F. Burghardt
Clerk

The role of nuclear medicine in evaluation of hepatobiliary disease has been drastically altered by the advent of the technetium 99m iminodiacetic acid (Tc-99m IDA) derivatives (1, 2). Cholescintigraphy has a primary role in the diagnosis of acute cholecystitis because of its ability to accurately depict cystic duct patency. The sensitivity, specificity, and overall accuracy in the acute clinical setting have been documented by numerous large series of patients to exceed 95% (3–7). In addition, its ability to detect acute acalculous cholecystitis (8), gallbladder perforation, and acute common duct obstruction extremely early in the clinical course, before positive results with other imaging techniques (e.g., ultrasonography [US]), has made cholescintigraphy an essential imaging procedure for evaluation of the acutely ill patient. The use of Tc-99m IDA cholescintigraphy for the detection of biliary leakage (9) (e.g., posttraumatic, postsurgical, spontaneous) and evaluation of complications associated with cholecystectomy, cholangiointestinal, and gastrointestinal anastomoses also has become well established (10, 11). Other indications include elucidation of defects on Tc-99m sulfur colloid liver scans, cholestasis (12), and selected cases of chronic right upper quadrant pain.

In order to appropriately utilize cholescintigraphy and US, an understanding of their relative strengths and weaknesses is essential. The information obtained from each is complementary. Technetium 99m IDA is an imaging agent that sensitively demonstrates every site where bile is forming and flowing, as well as functional changes that often precede anatomic responses in the development of biliary diseases. The major advantage of US is its exquisite anatomic resolution without the need for administration of contrast material.

Cholescintigraphy has the following advantages: (1) It is the best available examination for assessing cystic duct patency or occlusion, even in hyperbilirubinemia. (2) It is the most sensitive and specific imaging technique for the diagnosis of acute acalculous and calculous cholecystitis. (3) It can demonstrate gallbladder perforation: acute, subacute, chronic. (4) It can show surrounding anatomic structures and nonbiliary pathology. (5) It can demonstrate functional common bile duct obstruction before ductal dilatation occurs. (6) It is less dependent on technique than is sonography.

However, cholescintigraphy has certain limitations: (1) Its spatial resolution is inferior to that of sonography

From the Department of Nuclear Medicine, Montefiore Medical Center, Albert Einstein College of Medicine, Bronx, N.Y.

Plaintiff's
Exhibit 13

NEW MATERIAL WRITTEN AND

FIGURES SELECTED FOR RSNA - 1985

Hepatobiliary Imaging[1]

Heidi S. Weissmann, M.D.

sonographic findings.) (3) Occasionally cases of parenchymal liver disease (e.g., alcoholic hepatitis) or total parenteral nutrition may affect gallbladder filling. (4) Severe hepatic failure or sepsis may rarely interfere with hepatobiliary excretion of IDA compounds.

Advantages of US include the following. (1) It is the best available examination for detecting gallstones. (2) It can demonstrate gallbladder anatomy (e.g., size, wall thickness, pericholecystic fluid). (3) It can demonstrate surrounding anatomic structures without contrast media.

However, US has certain limitations: (1) It cannot provide functional information (e.g., cystic duct patency or occlusion). (2) Stones in cystic duct region are generally difficult to see. (3) US images are very dependent on technique (e.g., operator and equipment).

Technique

Patients should fast for 4–6 hours before intravenous injection of 1–5 mCi of Tc-99m IDA. This eliminates the possibility of interference with normal gallbladder filling by physiologic, postprandial gallbladder contraction. The usual dose is between 3 and 5 mCi. As little as 1 mCi has been successfully used in anicteric adults, and doses larger than 5 mCi may be helpful in cases of severe hyperbilirubinemia. A large field-of-view scintillation camera is preferable but not absolutely necessary. The camera should be positioned so that the

While the exact imaging sequence may vary from one institution to the next, there are two general principles to keep in mind when selecting a protocol. First, the procedure should be monitored as it is progressing, since cholescintigraphy is a dynamic study of hepatobiliary function. If a question arises, the answer may be lost if it is not worked out immediately, as labeled bile flows away from the area of concern or the region of interest becomes obscured by other structures that subsequently come into view. Thus, in the interest of greatest accuracy and reliability, the images should be examined as they are obtained. Second, it is most helpful if scintiphotos are obtained in the first 30–45 minutes with sufficient frequency to indicate how structures are filling and emptying. Hence, we prefer to obtain a scintiphoto at 1 minute for the blood pool phase, followed by views every 5 minutes for the first half hour. We then obtain a scintiphoto at 45 minutes and one at 60 minutes. At the end of 1–1½ hours, in a normal individual, the entire biliary system and duodenum should be visualized. If, for any reason, any of these structures are not identified, delayed views at 1½, 2, and 4 hours are obtained. The study may be terminated earlier if there is no significant persistence of hepatic activity when the intestinal activity is excluded from the field of view by a lead shield. Delayed views up to 24 hours may be useful in clinical situations known to promote biliary stasis, for example, prolonged fasting, hyperalimentation, alcoholism. Pharmacologic intervention with cholecystokinin or morphine administration has been suggested as a way to shorten the exam (14, 15).

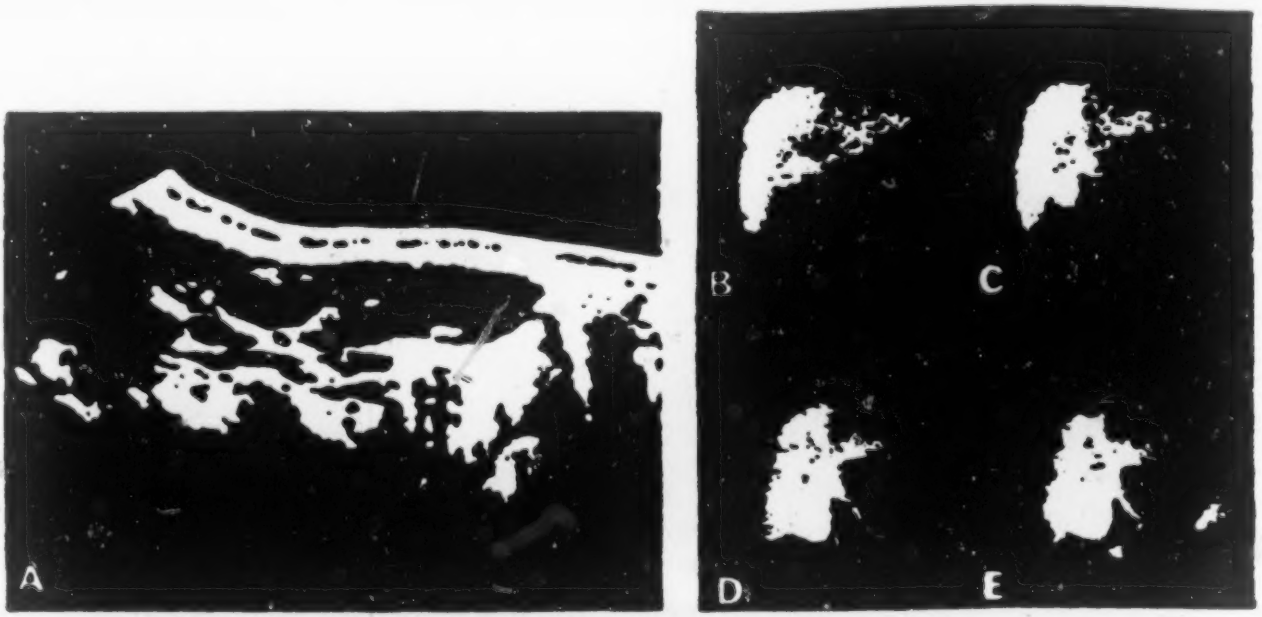

Figure 1. Cholelithiasis without acute cholecystitis (A) Longitudinal sonogram shows a calculus in the gallbladder with acoustic shadowing (B–E) Normal sequential series of IDA images in same patient, thereby ruling out cystic duct obstruction. (Reprinted, with permission, from reference 13.)

(e.g., generally does not reveal calculi). (2) Occasionally, a case of chronic cholecystitis may be associated with absent gallbladder visualization, even on delayed views. (However, this is a far less frequent cause of false-positive diagnosis for acute cholecystitis than with

liver, common bile duct, gallbladder, duodenum, and jejunum are included in the field of view. The anterior view is routinely obtained with each scintiphoto consisting of 500,000 counts. Additional views are obtained as the clinical situation dictates (13).

Figure 2. Nonvisualization of the gallbladder on an IDA cholescintigram in a patient with acute cholecystitis. Sequential scintigraphs at 5 minutes (A), 25 minutes (B), 45 minutes (C), and 90 minutes (D) show prompt hepatic uptake, excellent ductal visualization, and normal excretion into the intestine. Lack of gallbladder visualization, including a 4-hour follow-up view (not shown), indicates cystic duct obstruction. (E) Normal US examination, same patient. (Reprinted, with permission, from reference 16.)

Acute Cholecystitis

At many institutions technetium 99m IDA cholescintigraphy has become the diagnostic procedure of choice when acute cholecystitis is suspected because it is the most sensitive, accurate test available to answer the key diagnostic imaging question, Is the cystic duct patent (Fig. 1) or obstructed (Fig. 2) (3, 5–8)? Cystic duct obstruction is the most significant imaging finding because more than 95% of cases of acute cholecystitis are associated with such obstruction at some point in the development of the disease (Fig. 2). Cholelithiasis, on the other hand, is not a sine qua non for acute cholecystitis in view of its prevalence in the United States (20 million Americans). Hence, documenting cholelithiasis in a patient presenting with acute abdominal pain is insufficient evidence that the stones are the cause of the patient's acute clinical presentation (16, 17). Cholelithiasis has been an incidental finding in up to 50% of patients, particularly elderly patients, presenting with

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B
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D

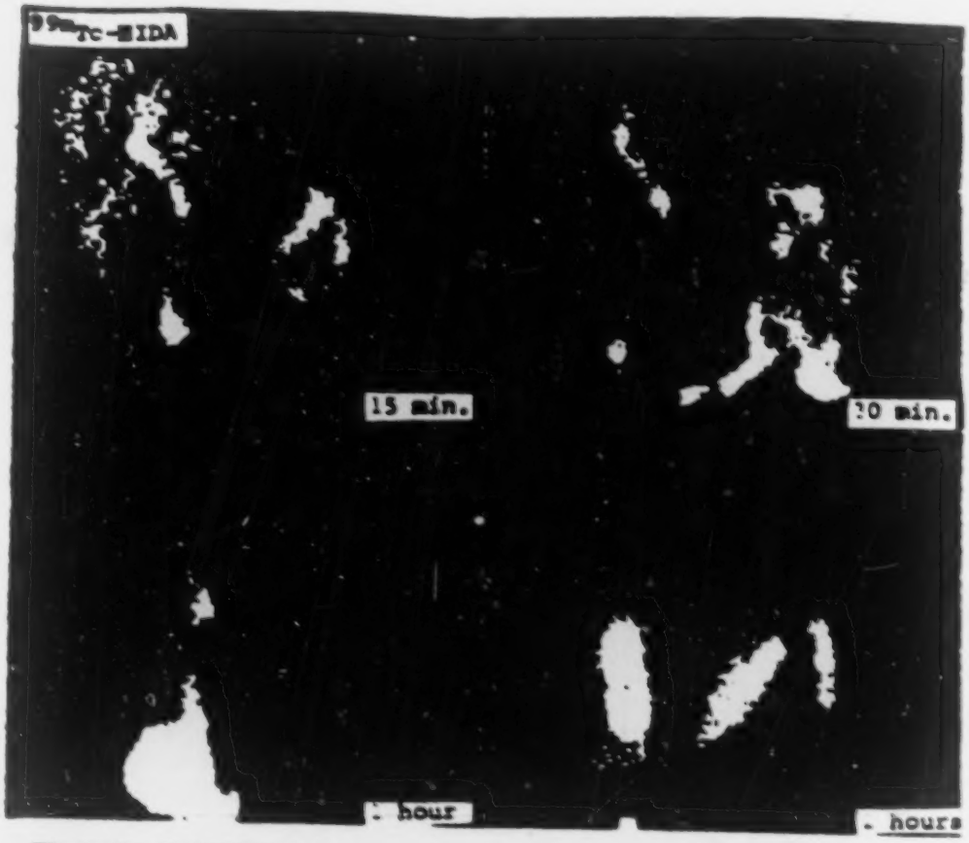

Figure 3. Delayed gallbladder visualization in chronic cholecystitis. Sequential scintiphotos through 1 hour show good filling of the common bile duct and prompt excretion into the intestine. The 1½-hour study (not shown) also failed to demonstrate gallbladder visualization. The gallbladder finally fills at 2 hours. (Reprinted, with permission, from reference 15.)

symptoms suspicious for acute cholecystitis (Fig. 1). The incidence of asymptomatic cholelithiasis has been shown to increase with increasing age in autopsy series.

Technetium 99m IDA imaging has many advantages that make it the procedure of choice for suspected acute cholecystitis. It is a rapid, safe, and simple procedure that provides functional as well as anatomic information. There are no absolute contraindications, and the only relative contraindication is pregnancy. Cholescintigraphy has proved to be more accurate and reliable than other modalities previously and currently in use. For example, evaluation of 323 consecutive patients revealed an overall accuracy of 97.6%; the false-positive rate was 0.58% and the false-negative rate, 4.8% (4).

The primary diagnostic criterion is the presence or absence of gallbladder visualization, corresponding to cystic duct patency and obstruction, respectively. A normal cholescintigram effectively excludes the possibility of acute cholecystitis (Fig. 1), whereas persistent nonvisualization of the gallbladder (up to 4 hours) despite prompt hepatic uptake and excretion (Fig. 2) has proved diagnostic in the acute clinical setting. When gallbladder visualization is delayed (between 1 and 4 hours), chronic cholecystitis is considered much more likely (Fig. 3). However, the possibility of acute inflammatory disease is not definitely excluded, because about 3.5% of patients with acute cholecystitis exhibit delayed gallbladder visualization.

Additional cholescintigraphic advantages in the acute clinical setting include the ability to detect other causes of significant biliary pathology that can mimic the acute clinical presentation of acute cholecystitis, such as gallbladder perforation (Fig. 4) and acute common duct obstruction (Fig. 5). In numerous instances, cholescintigraphy shows these abnormalities very early in their pathophysiologic development, frequently before sonography and occasionally even before the liver function tests are abnormal. If a persistent hepatocyte phase without biliary visualization is obtained in an acutely ill patient, common duct obstruction is the most likely cause. Although this scintigraphic pattern is not pathognomonic, in this clinical setting it strongly suggests a significant common duct obstruction (positive predictive value greater than 95%). Typically, sonography is falsely negative in these cases (70%) (13). This is probably due to the fact that the ducts have not yet dilated in response to the obstruction, or that choledocholithiasis can result in transient and intermittent obstruction, of the "ball-valve" type, such that the ducts may never dilate to be sonographically detectable. Therefore, sonography is only helpful in these instances if it is positive. If the US study is negative for biliary obstruction, further evaluation with endoscopic retrograde pancreaticoduodenography or percutaneous transhepatic cholangiography is warranted.

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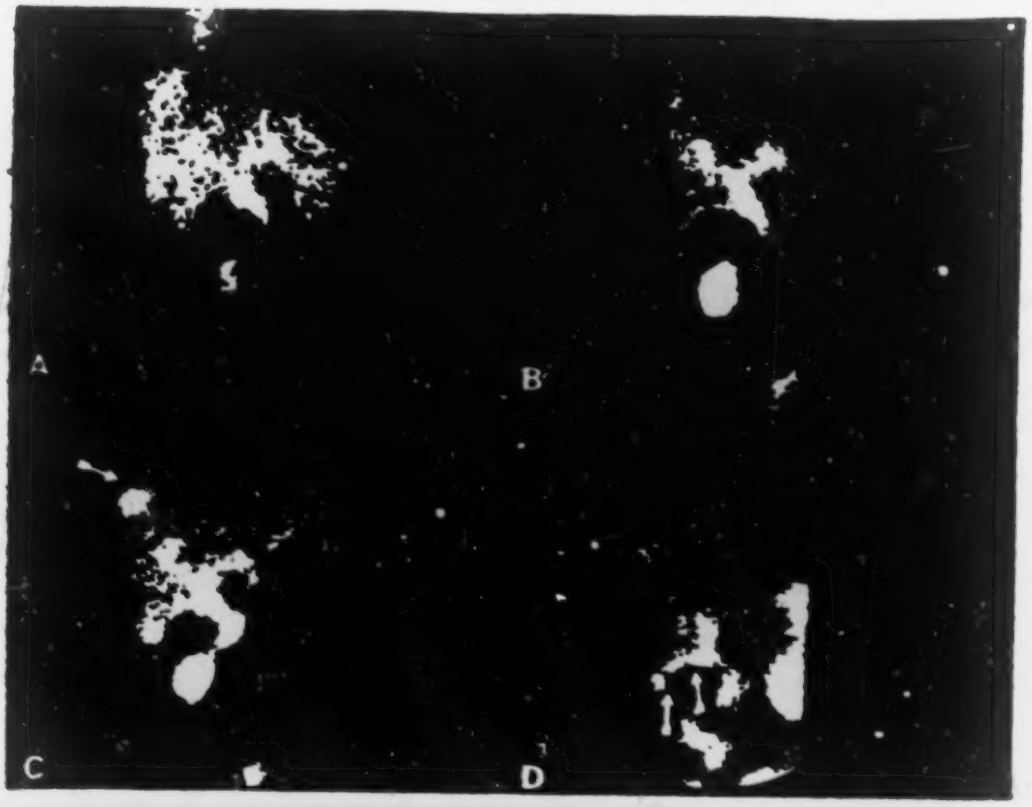

Figure 4. Acute acalculous cholecystitis with perforation. This 77-year-old woman had had an acute myocardial infarction several days earlier. She had severe right upper quadrant pain for 24 hours. At 15 (A) and 30 minutes (B), the common bile duct and intestine are visualized. At 1 hour (C), a hot spot appears at the dome of the right lobe (arrow). A minimal amount of activity along the right lower liver margin also appears at 1 hour and persists at 2 hours (D) (arrows), as does the hot spot. This represents delayed visualization of a subtotally obstructed cystic duct and gallbladder. The hot spot represents leakage. Sonography showed "sludge" only. Because of patient's poor clinical condition, a laparotomy was performed under local anesthesia. A coin-sized area of ischemic necrosis of the gallbladder fundus with bile leakage was identified and resected. A cholecystostomy tube was inserted. Vascular insufficiency was thought to be the most likely cause of the acalculous cholecystitis. (Reprinted, with permission, from reference 13.)

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False-Positive Studies for Acute Cholecystitis

Several causes of false positive IDA studies have been reported. These are as follows.

Chronic cholecystitis.—There are several possible explanations for this finding. As shown by Freitas et al. (18), the most important problem lies in pathologic classification as to what histologically constitutes acute cholecystitis. It is much more appropriate to utilize liberal criteria (cystic duct stone, focal changes, etc.) rather than strict criteria (transmural inflammatory changes).

Other problems include (1) difference in statistical criteria used; (2) defining nature of disorder being studied, for example, acute cholecystitis versus "gallbladder disease"; (3) symptoms of patient population selected, for example, acute, subacute, chronic; and (4) delayed views, failure to perform, or misinterpretation of significance.

Acute pancreatitis.—Edlund et al. (19) reported that five of seven cases of acute pancreatitis failed to show "normal IDA visualization." The studies were terminated at 1 hour, therefore, the possibility of delayed gallbladder visualization was ignored. This is particularly important to assess in this clinical context because of the strong possibility of biliary pancreatitis. Additionally, the cases were not well documented, and this study has been refuted by five separate reports (20–24) that showed no false-positive results in a total of 152 patients studied. Most important, the IDA study was found in these studies to be a superb means of distinguishing between biliary and nonbiliary causes of pancreatitis.

Alcohol abuse (e.g., hepatitis and cirrhosis).—Shuman et al. (25) reported nonvisualization or delayed visualization of the gallbladder in 20 of 41 alcoholics. Nine of the 20 presumably had false-positive results. Twenty-nine alcoholic patients in three separate series with nonbiliary acute pancreatitis had normal studies. In the series of Serafini et al. (20), six alcoholic patients with biliary pancreatitis had abnormal studies, correctly predicting that biliary disease and not alcohol was the culprit.

Total parenteral nutrition.—Shuman et al. (25) encountered great difficulty in this area, which is also associated with prolonged fasting. Although our prob-

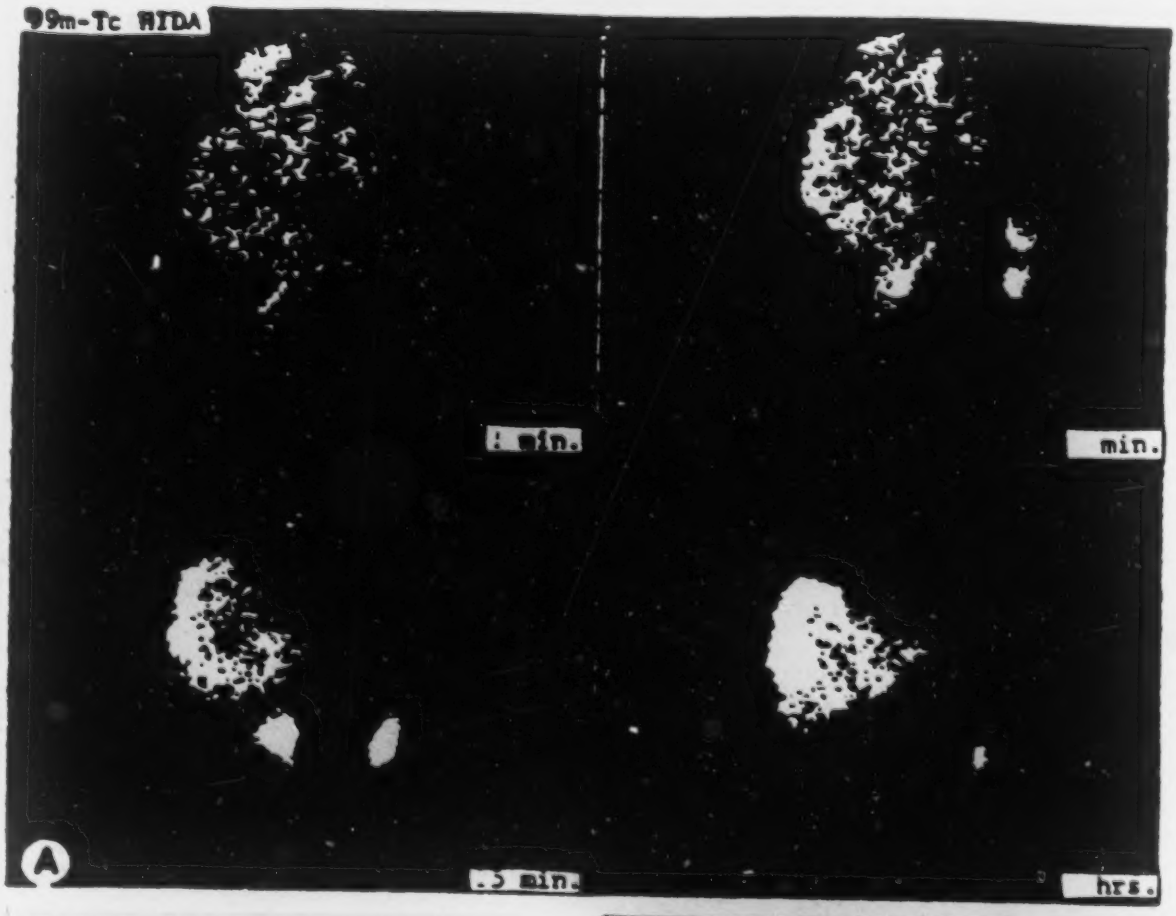
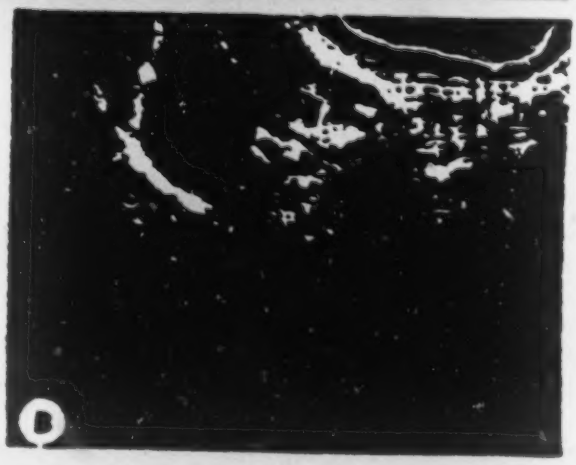


Figure 5. Complete obstruction of the common bile duct. (A) Sequential Tc-99m dimethyl IDA images over 3 hours show initially slow hepatic uptake with subsequent good peaking of activity at 15 minutes. Enhanced renal excretion is also apparent up to this point. At 3 hours, there is still total retention of the radiotracer in the liver. (B) US examination 1 hour later shows a normal-sized common hepatic duct (arrow). The intrahepatic and common bile ducts (not shown) also appeared normal. Common bile duct calculi were found at laparotomy. (Reprinted, with permission, from reference 13.)



lems in this area have been minimal, it warrants further study. Since this population is definitely more susceptible to acalculous cholecystitis, nonvisualization of the gallbladder may be of prognostic significance. Identification of this altered physiologic state may be identifying those patients who would benefit from routine cholecystokinin therapy to keep the gallbladder active and counteract bile stasis.

Prolonged fasting.—Larsen et al. (26) and Kalff et al. (27) have presented case reports suggesting problems in this area, but a well-controlled study of a series of patients is necessary to evaluate the effect of prolonged fasting and to determine if and when optimal fasting (see below) becomes "prolonged" fasting.

Inadequate fasting.—Using normal volunteers, Klingensmith et al. (28) reported that seven of 11 gallbladders were not visible when studies were commenced 15–30 minutes after a meal (64% false-positive results). All 11 cases had visualized normally following an overnight fast. Baker et al. (29) had shown earlier similar results with Tc-99m PG (pyridoxylidene glutamate).

Overall, in regard to the controversies that have existed concerning cholescintigraphy and US in evaluating patients with acute cholecystitis, it is essential that we keep the proper perspective concerning patient care. The situation was beautifully summed up by James Caldwell (30), a gastroenterologist at Ohio State: "I believe that the choice of diagnostic procedure depends on what the clinician needs to know, and how rapidly he needs the answer. If the patient has a truly acute illness with supporting physical findings, a positive scintiscan will end the workup for the majority of otherwise healthy patients. If the patient has chronic biliary colic,

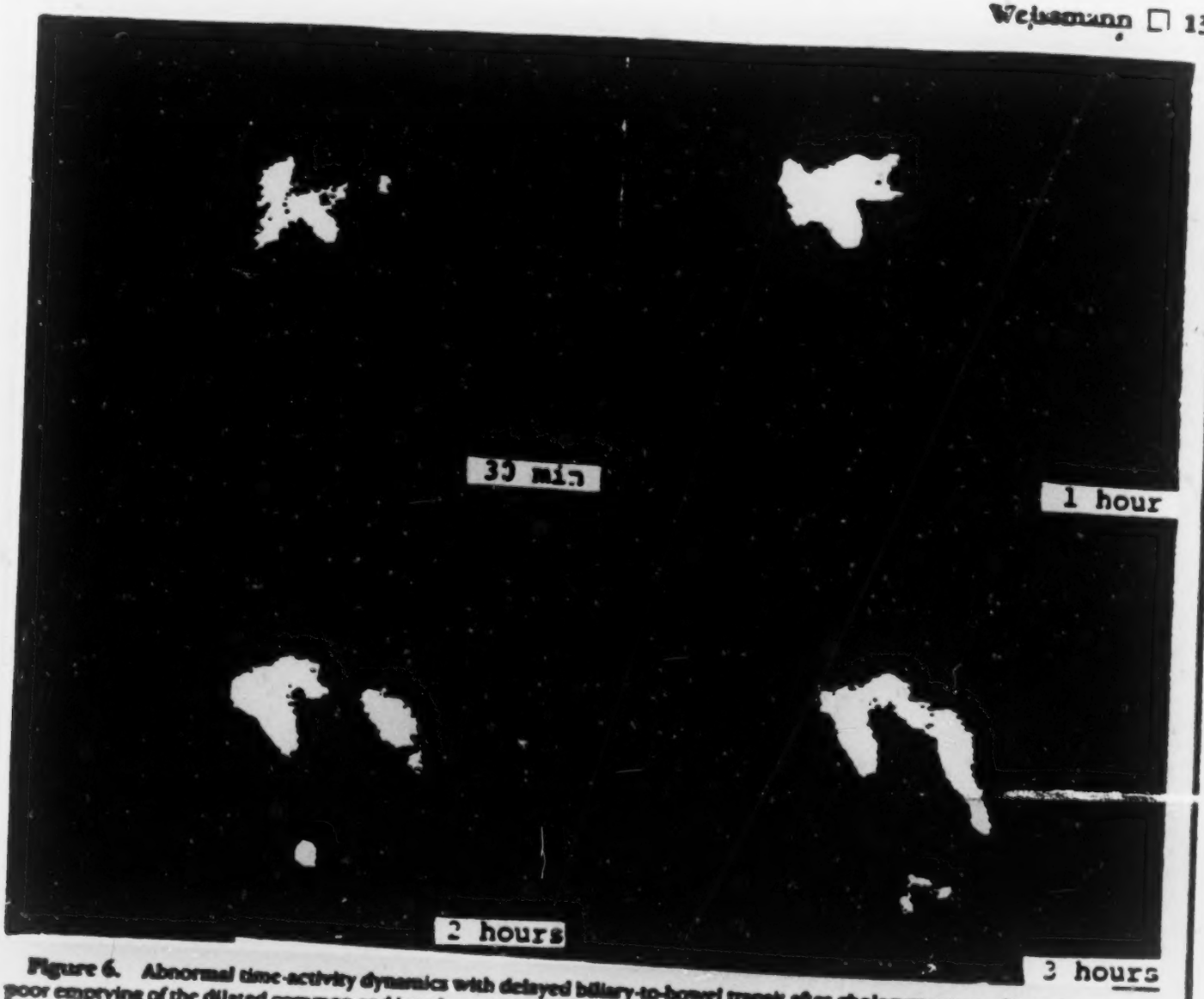


Figure 6. Abnormal time-activity dynamics with delayed biliary-to-bowel transit after cholecystectomy. Note the very poor emptying of the dilated common and intrahepatic ducts. The amount of ductal activity at 2 and 3 hours does not significantly change from the 1-hour study. (Reprinted, with permission, from reference 11.)

and is not acutely ill, ultrasound may be positive for stones while scintiscanning may be negative."

Caldwell concludes his article by saying, "We should not labor in a clinical vacuum, and our tests should not be disembodied images unconnected to the total clinical problem. When diagnostic uncertainty exists, consultation among all involved physicians is in order. Understanding by clinicians of differences in techniques, equipment, technical support, imaging agents and experience should resolve conflicts in the patient's interest."

Serendipitous Detection of Nonbiliary Pathology

Clearly, cholescintigraphy is performed to evaluate the biliary system. However, important additional information can be obtained by examining the four nonbiliary phases of this study: blood pool, hepatocyte, renal excretory, and intestinal. In 9.5% of cases, the serendipitous detection of previously unsuspected nonbiliary pathology correctly directed the patient's work-up away from the erroneously suspected acute cholecystitis and toward the true source of the patient's acute symptoms (31).

Chronic Cholecystitis

The clinical utility of cholescintigraphy in chronic cholecystitis is limited by three major factors:

1. Since chronic cholecystitis is most commonly associated with cholelithiasis, the key question to be answered by imaging is, Are gallstones present? Cholescintigraphy does not have the anatomic resolution to demonstrate stones directly; therefore, US and oral cholecystography must be considered the diagnostic mainstays in chronic cholecystitis.

2. A patient with chronic cholecystitis usually has a functionally patent biliary system; therefore, normal re-

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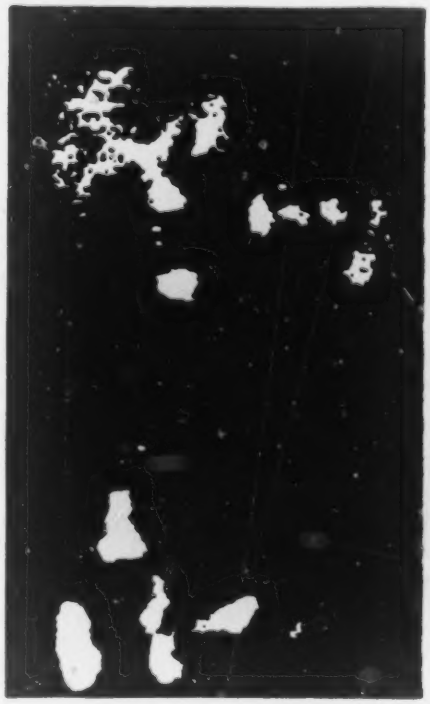

Figure 7. Patent biliary-enteric anastomoses. Free flow of Tc-99m IDA through a choledochoduodenostomy in one patient (a) and a choledochojejunostomy in another patient (b) is clearly demonstrated. (Reprinted, with permission, from reference 11.)

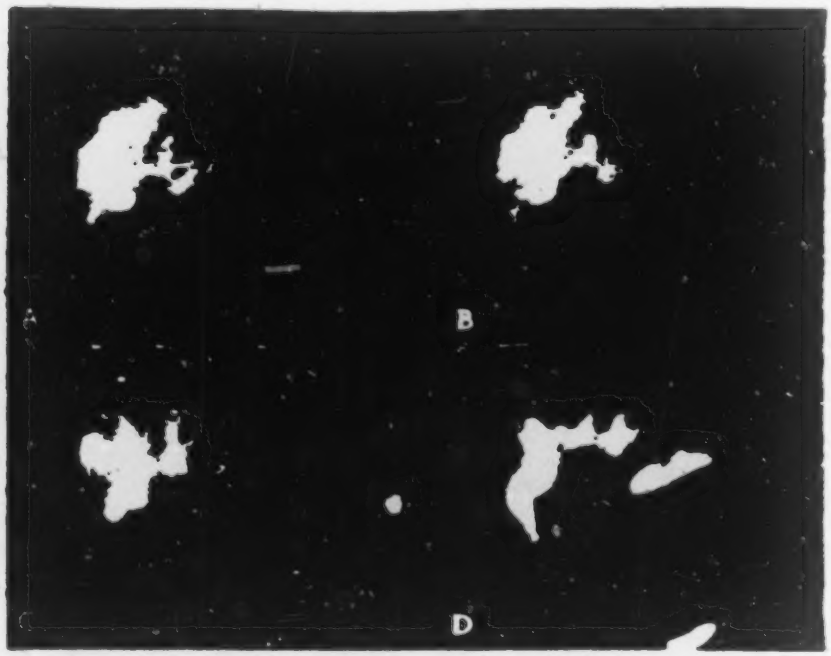

Figure 8. Patent choledochoduodenostomy. Dilated biliary radicles with free flow of Tc-99m IDA. Scintiphotographs obtained at 10 (A), 15 (B), and 25 (C) minutes show the dilated biliary tree with progression of labeled bile through the choledochoduodenostomy anastomosis. At the end of the first hour (D), most of the Tc-99m IDA had been excreted from the liver into the biliary tree and through the anastomosis into the intestine. Most intestinal activity was shielded by a lead apron to better visualize the dilated intrahepatic biliary radicles. The bypass was performed for obstructing choledocholithiasis. Despite the success of the surgery in relieving the obstruction, the biliary tree remained ectatic. This case illustrates that a dilated biliary system is not necessarily an obstructed system. (Reprinted, with permission, from reference 32.)

sults on a cholescintigram do not exclude the possibility of chronic cholecystitis.

3. Individuals with chronic cholecystitis exhibit a wide spectrum of cholescintigraphic patterns, depending on whether the cystic or common bile ducts are partially or completely obstructed by stones or sludge. While some of these patterns are highly suggestive—for example, delayed visualization of the gallbladder (Fig. 3)—none is truly pathognomonic for chronic cholecystitis. Nevertheless, in specific cases of chronic cholecystitis, IDA imaging has proved particularly useful, for example, in helping the clinician determine whether a patient with known chronic cholecystitis (usually documented by a previous OCG or sonogram) has acute symptoms because of a superimposed acute exacerbation of the known gallbladder disease. IDA imaging is also helpful in identifying the occasional false-negative OCG and sonogram in cases where clinical suspicion of chronic cholecystitis remains high despite a "normal" OCG or sonogram.

Postoperative Evaluation

Cholescintigraphy is extremely useful in evaluating patients postoperatively. For instance, in the symptomatic postcholecystectomy patient, visualization of a normal-sized duct that empties within 1 hour rules out significant pathology with a high degree of accuracy (97%). A spectrum of abnormal findings has been identified (11). Cholescintigraphy has also proved useful in detecting common duct obstruction (Fig. 6), cystic duct remnants, and bile leaks.

Patients who have undergone biliary enteric bypass surgery can be evaluated for patency of the anastomosis by cholescintigraphy, regardless of the level of the anastomoses, including hepatoduodenostomy, choledochoduodenostomy, choledochojejunostomy, etc. (Fig. 7). Unlike attempts at opacification with the iodinated contrast agents, the use of Tc-99m IDA allows routine visualization of the ducts and anastomosis without the need for a competent sphincter of Oddi (Fig. 8). In addition, it is a "physiologic" procedure that can clearly document the presence and preferential route of flow of an anastomotic bile leak (Fig. 9), as opposed to the nonphysiologic T-tube study, percutaneous cholangiography, and upper gastrointestinal series.

Detection of Biliary Leakage

Cholescintigraphy is useful in evaluating nonsurgical as well as surgical trauma. It is particularly well suited to the evaluation of patients with blunt abdomi-

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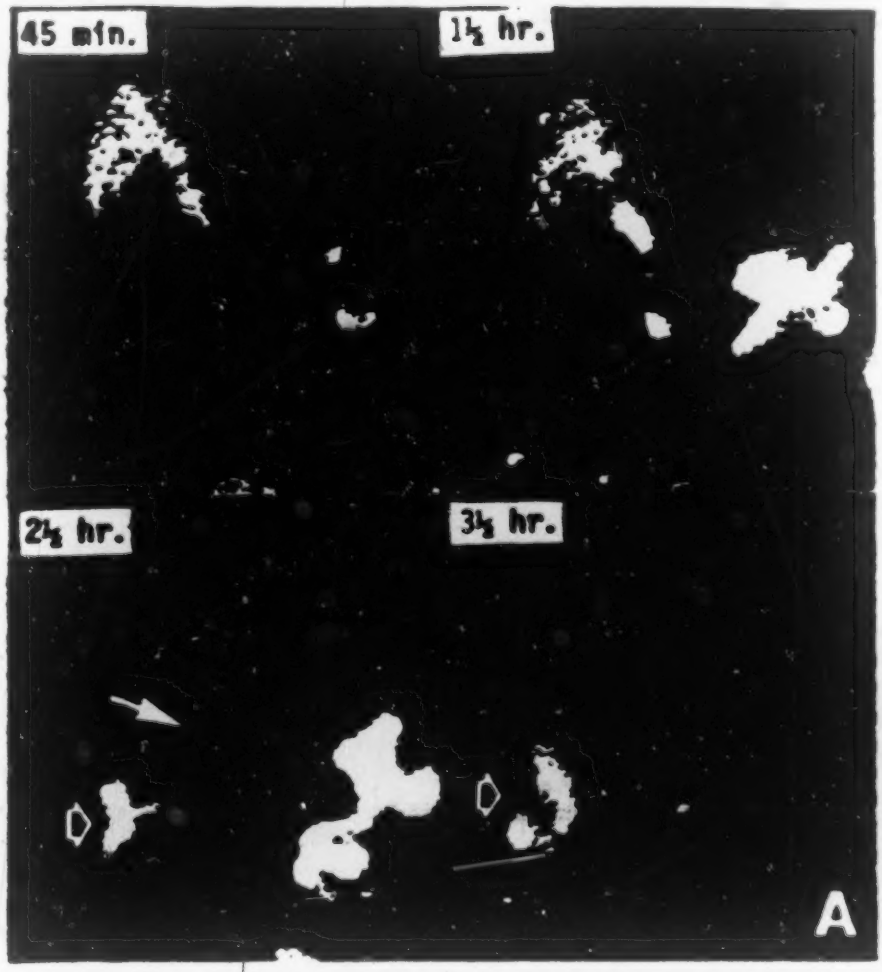

Figure 9. Anastomotic leak. (A) First postoperative Tc-99m IDA cholescintigrams (s/p cholecystectomy and choledochoduodenostomy). Radiotracer flows normally into the bowel on a 45-minute study. The 1½-hour image began to show a very faint tract of abnormal tracer activity in the anastomotic region, 2½-hour and 3½-hour images clearly demonstrate abnormal bile flow. Without the delayed (more than 1 hour) images, the anastomotic leak would have gone undetected. (Fig. 9 continued on next page.)

nal injuries because it does not require a communicating tract with the skin surface. It has also been found useful to obtain serial studies in cases of biliary leakage to evaluate the response to therapy, such as external drainage (Fig. 9) or the results of surgical intervention.

Cholestasis

The role of scintigraphy in cholestasis is limited by its poorer anatomic resolution, when compared with other procedures, such as US and CT. Nonetheless, it has proved useful as a screening procedure and in specific clinical situations, such as acute common bile duct obstruction and localized intrahepatic obstruction. Ideally, the best initial procedure in the evaluation of the jaundiced patient is sonography. Not only can it show ductal dilatation with a high degree of accuracy, but it also frequently demonstrates the level and cause of obstruction. However, since sonography requires greater technical expertise and physician participation, cholescintigraphy can be used as a screening procedure if US facilities are overburdened. The IDA derivatives allow visualization of the biliary tract in cases of hyperbilirubinemia. In particular, Tc-99m diisopropyl IDA (DISIDA) is well suited for imaging the nonobstructed biliary system and has enabled visualization of the patent biliary tree when the bilirubin level has been as high as 30 mg%. When a normal biliary tract is visualized in a jaundiced patient, no further workup for biliary obstruction need be pursued. On the other hand, when dilated, obstructed biliary radicles are seen and the level of obstruction is identified (Fig. 6), or a nondiagnostic study is obtained, further evaluation with the procedures that have better anatomic resolution should be done. In addition to its utility as a screening procedure, cholescintigraphy has at times been diagnostic of obstruction when other modalities such as sonography and transhepatic cholangiography have failed. These mainly include cases of acute common bile duct obstruction (where the functional abnormality of obstruction has been detected before the morphological change of dilation is present [Fig. 5] and occasionally even before the liver function tests have become abnormal) and areas of localized intrahepatic ductal obstruction.

Congenital Disorders

Technetium 99m IDA cholescintigraphy also has an important role to play in the diagnosis of congenital biliary disorders, such as differentiating between neonatal hepatitis and biliary atresia and evaluating neonatal hepatomegaly. Caroli disease, congenital hepatic fibrosis, and situs inversus (13).

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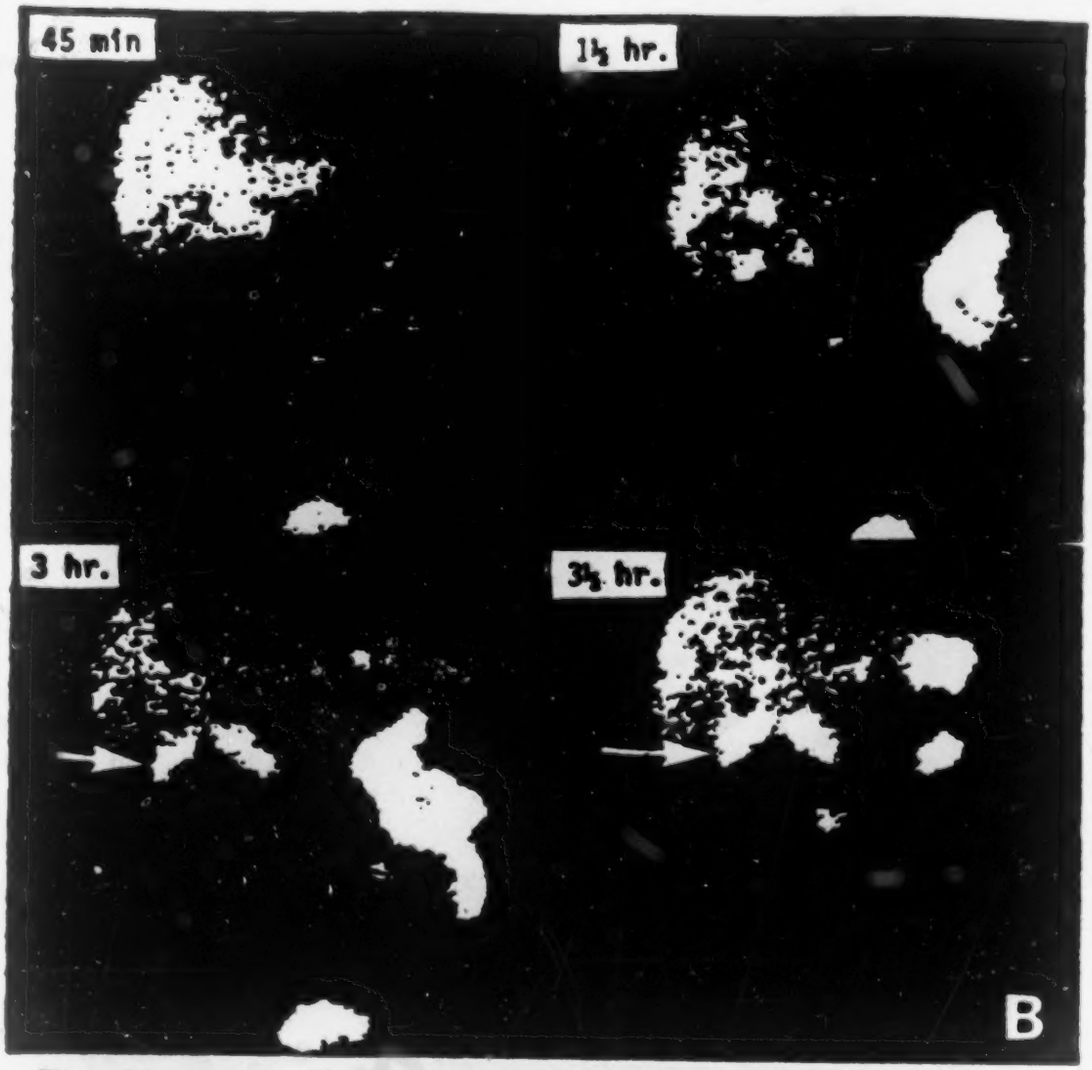

Figure 9 (*continued*). (B) Repeat Tc-99m IDA cholescintigrams 11 days after the first postoperative study and treatment with external drainage show significant improvement, with only small amount of activity in the cavity that had formed (arrows). (Reprinted, with permission, from reference 33.)

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